
United States Court of Appeals

FOR THE NINTH CIRCUIT

No. 16168

VAN BRODE MILLING CO., INC.,

Appellant,

—VS.—

COX AIR GAUGE SYSTEM, INCORPORATED,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF CALIFORNIA, CENTRAL DIVISION

APPELLANT'S OPENING BRIEF

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JURISDICTION

The present action is for patent infringement and unfair competition. The patent involved is United States Letters Patent No. 2,710,660, dated June 14, 1955, issued to Sidney Coleman and assigned to appellant. The jurisdiction of the district court of the Patent Count arises under the Patent Laws of the United States (Title 35 of U. S. C.) and Section 1338(a) of Title 28 of U. S. C. The unfair competition count relates to the sale by the appellee of the same article as is alleged to infringe the patent, and jurisdiction of this count arises under Section 1338(b) of Title 28 of the U. S. C. and under Section 1332, there being diversity of citizenship between the parties and the amount of controversy exclusive of interest and costs exceeding the amount of Three Thousand (\$3,000.00) Dollars.

Appellee interposed a counterclaim for declaratory judgment as to the validity and infringement of United States Letters Patent No. 2,710,660 aforesaid, and the district court had jurisdiction of the counterclaim under the Patent Laws of the United States (Title 35 of U. S. C.) and Sections 1338, 2201, and 2202 of Title 28 of U. S. C.

The pleadings showing the existence of the jurisdiction of the district court are the complaint, answer and reply (R. pp. 3-14).*

This court has jurisdiction to review the Final Judgment (R. pp. 57-58) herein under Sections 1291 and 1294(1) of Title 28 of the U. S. C.

The Final Judgment was filed and entered May 20, 1958, and on June 10, 1958, within the statutory time for filing a Notice of Appeal, a Notice of Appeal from each and every part from the aforesaid Judgment was filed in the district court. By stipulation dated June 23, 1958, filed in the district court on July 8, 1958 appellant's time to file its Record on Appeal and docket its appeal pursuant to Rule 73(g) of the Federal Rules of Civil Procedure was extended to September 8, 1958, the extension of time being within the 90-day period provided for in Rule 73(g). The Record on Appeal was transmitted on August 22, 1958, and the appeal was docketed September 3, 1958. On September 8, 1958 appellant applied to this court for additional time to file its Statement of Points and Designation of Record until September 28, 1958. The application was granted and the Statement of Points and Designation of Record were filed on September 18, 1958.

Appellant's time to file the present brief was extended by this court to July 20, 1959.

* The above page reference and all page references made hereinafter are to pages of the Record on Appeal unless otherwise specified.

STATEMENT OF THE CASE

The Complaint herein was filed September 3, 1957, the Answer and Counterclaim filed October 8, 1957 and the Reply was filed October 28, 1957. The charges of patent infringement and unfair competition arise out of the sale by appellee of plastic battery hold-down frames allegedly embodying the invention of the suit patent and simulating appellant's plastic battery hold-down frames manufactured under the patent in appearance, particularly as to color and shape. The accused frames are supplied to appellee by Kravex Manufacturing Corp. of 273 Van Sinderen Avenue, Brooklyn, New York (hereinafter referred to as "Kravex"), and are molded for Kravex by Gary Enterprises, Inc. of 249—49th St., Brooklyn, New York (hereinafter referred to as "Gary").

Appellee denied patent infringement and contended that the suit patent is invalid for a number of reasons, the principal ones being lack of invention over certain prior art, lack of utility and lack of sufficient disclosure. Appellee's contentions regarding invalidity and non-infringement are also embodied in its counterclaim.

On the issue of validity, appellant relied on testimony of independent witnesses from the automotive trade as establishing that the invention of the suit patent had solved a long existing problem, a fact not controverted by appellee, and on documentary evidence as well as testimony of witnesses as establishing commercial success of its patented frames. On the issue of infringement, appellant relied on the testimony of an expert in the plastics field, an expert on batteries and on a stipulation.

Appellee relied on the testimony of an expert witness, and on several patents and publications in support of its contention that the suit patent is invalid for lack of invention; relied on the testimony taken by deposition of the inventor and officers of appellee in support of its contention

that the suit patent is invalid for lack of utility; and relied on an expert witness in support of its contention of invalidity because of lack of sufficient disclosure and in support of its claim of non-infringement.

On the question of unfair competition, appellee denied that appellant had any rights in the color and shape of its frames which have been violated by appellee. More particularly, appellee contended in this regard that the color and shape of its frames were functional and that appellant had not established secondary meaning regarding the color and shape of its frames. Appellant claimed on the other hand that the simulation of its frames by appellee's supplier in which simulation appellee participated was deliberate and that appellant's frames had in fact acquired secondary meaning as to color and shape.

To establish its contentions regarding unfair competition, appellant relied on the testimony taken by deposition of officers of appellee's supplier, Kravex, and the latter's molder, Gary. Also relied on was the testimony of witnesses in the automotive trade as to secondary meaning and the testimony of officers of appellant.

After trial of the case on the days of March 25 through 28, 1958, decision was rendered by the district court in an opinion filed April 21, 1958, dismissing both counts of the complaint, and sustaining the appellee's counterclaim for declaratory judgment declaring the patent invalid and non-infringed. The district court held that the suit patent was invalid for lack of invention over the prior art, lack of sufficient disclosure and lack of utility. Said court also held that the patent was not infringed by appellee's product. On the issue of unfair competition the lower court held that appellant had no exclusive right to appropriate the particular color and size of its battery hold-down frames, that the color and shape of the frames were functional, that appellant had not established secondary meaning in the same, and that, therefore, it had no rights which were being infringed by the appellee. No transcript of the testimony

was employed by the court prior to rendering its decision nor were any briefs after trial taken.

The district court's Findings of Fact and Conclusions of Law (R. pp. 41-57) were signed on May 20, 1958, and the Final Judgment was entered May 20, 1958.

SPECIFICATION OF ERRORS RELIED ON BY APPELLANT

I.

Regarding the patent infringement count, appellant relies upon the following errors:

1. The court erred in making Finding of Fact No. 26 (R. p. 48). The reason is that the suit patent does not define the plastic material of which the hold-down frames are made "loosely" as stated in said finding. The definition of the material as polystyrene modified by a Buna S having a high styrene content may be broad, but it is not a loose definition.

2. The court erred in making Finding of Fact No. 31 (R. p. 49) because there was no evidence that beginning in 1948 the literature in the field of rubber resins taught the use of high styrene copolymers to effect greater strength in plastic materials. The evidence showed that only a few isolated experiments had been made prior to 1952, a date subsequent to the date of invention of the suit patent.

3. The court erred in making Finding of Fact No. 32 (R. p. 49) because the prior art referred to therein does not teach that a "high styrene-butadiene copolymer" [high styrene butadiene-styrene copolymer]* was blended with polystyrene to give tough blends with higher elongation impact strength and good mold flow. Also, said Finding should not have been made because

* The bracketed material is inserted for sake of accuracy; apparently, the quoted phrase refers to a butadiene-styrene copolymer having a high styrene content; otherwise, it makes no sense at all. The court's confusion as to terms and definitions will be referred to at greater length hereinafter.

it is irrelevant; the suit patent does not relate to plastics but to a particular article made of a particular type of plastic so that the teachings referred to have nothing to do with the issue of inventiveness of the suit patent.

4. The court erred in making Finding of Fact No. 33 (R. p. 49) because the inventor of the suit patent did teach how to combine polystyrene with a copolymer of butadiene and styrene having a high styrene content to produce a plastic having the appropriate durability as a battery hold-down frame; this was not taught and known in the art long before him.

5. The court erred in making Finding of Fact No. 34 (R. p. 50) because the public literature produced at the trial and admitted in evidence does not define high styrene butadiene-styrene copolymers as being only those having styrene contents ranging from 70% to just under 95% by weight, but on the contrary shows that such copolymers are ones having styrene contents higher than the 25% present in standard synthetic rubber, the basic butadiene-styrene copolymer. This Finding is also wrong because of the implication that the only definition of high styrene content in the suit patent limits the term to meaning 70% styrene in the butadiene-styrene copolymer used to modify polystyrene, whereas the 70% styrene butadiene-styrene copolymer mentioned in the patent was given as an example, not a limitation.

6. The court erred in making Finding of Fact No. 35 (R. p. 50) because the range of styrene contained in styrene-butadiene copolymers does not vary from almost none to almost 100% styrene but varies in accordance with the amounts present in certain specific known and synthesized copolymers.

7. The court erred in making Finding of Fact No. 37 (R. p. 50) because the term high styrene content as used in the specification and claims of the patent in suit to describe the butadiene-styrene copolymer employed to modify polystyrene means more than 25%

not more than 50% as found, and the Finding is contrary to the weight of the evidence.

8. The court erred in making Finding of Fact No. 38 (R. p. 50) because this Finding is contrary to the weight of the evidence which established that the specification of the suit patent does contain a description of the invention sufficient to apprise one skilled in the art as to how to practice the invention and does set forth the best mode of carrying out the invention known to the inventor at the time the application for the suit patent was filed. The specification discloses that the invention is the fabrication of a plastic battery hold-down frame from a particular type of plastic material comprising polystyrene modified by a Buna S (butadiene-styrene copolymer) having a high styrene content to improve its physical and mechanical properties whereby the battery hold-down frame has the heat resistance, building strength and toughness as well as enough flexibility to function successfully as such.

9. The court erred in making Finding of Fact No. 39 (R. pp. 50-51) because the patent does conclude with claims particularly pointing out and distinctively claiming the subject matter of the suit patent. The claims clearly recite that the invention is the provision of a battery hold-down frame having certain recited mechanical features from a plastic material recited to comprise polystyrene modified by a Buna S having a high styrene content to improve its (the polystyrene's) physical and mechanical properties whereby the battery hold-down frame has the heat resistance, building strength and toughness as well as enough flexibility to function successfully as such.

10. The court erred in making Finding of Fact No. 40 (R. p. 51) because this Finding is contrary to the weight of the evidence; specifically, the testimony of appellant's expert and the undisputed fact of what appellee's supplier Kravex and its molder Gary were able to do with the benefit of the teachings of the suit

patent show that the suit patent teaches how to make a plastic battery hold-down frame having the desired characteristics.

11. The court erred in making Finding of Fact No. 41 (R. p. 51) because this Finding is contrary to the weight of the evidence which established that the term high styrene content as applied to butadiene-styrene copolymers had at the date of filing of the application and now has a definite meaning. In addition, there is nothing in the record to justify the statement in this Finding that if the term high styrene content includes a range extending below 50% styrene said range would be too broad and would give the patent holder more than he would be entitled to. The reason is that no prior art was submitted showing the making of a battery hold-down frame from plastic of any kind whatsoever, and in claiming a battery hold-down frame restricted to a particular type of plastic the inventor certainly did not ask for and obtain more than that to which he was entitled.

12. The court erred in making Finding of Fact No. 42 (R. p. 51) because this Finding is both inaccurate in its implication and irrelevant in its actual language. Invention is not claimed in the suit patent for the mere use of a butadiene-styrene copolymer having a high styrene content; invention was claimed in the creation of a plastic battery hold-down frame from polystyrene modified with such a copolymer. This Coleman unquestionably did invent. The court erred in finding that the patent did not amount to invention over the prior art on the basis that Coleman was not the inventor of the particular plastic *per se* mentioned in his patent—Coleman never claimed to be the inventor of a new plastic.

13. The court erred in making Finding of Fact No. 43 (R. pp. 51-52) because the art referred to in this Finding unquestionably does not show the elements of the patented invention inasmuch as none of it discloses plastic battery hold-down frames of any kind what-

soever. The same is true with respect to U. S. Patent No. 2,578,518, dated December 11, 1951, to Ditz *et al.*, also referred to in this Finding.

14. The court erred in making Finding of Fact No. 44 (R. p. 52) because this Finding is contrary to the weight of the evidence which established that the copolymer employed in appellant's plastic to modify the polystyrene thereof has a high styrene content. The reason is that high styrene content means higher than 25% which is the styrene content in standard G. R. S., the basic butadiene-styrene copolymer employed as a general all-purpose substitute for rubber.

15. The court erred in making Finding of Fact No. 47 (R. p. 52) because this Finding is contrary to the weight of evidence which established that when appellant employed the combination of polystyrene and Darex Copolymer No. 3 it was able to produce a commercially acceptable frame. The evidence established clearly that appellant sold a large quantity of frames made of its original formulation, that it used a great deal of Darex Copolymer No. 3 to make such frames; and that its returns on them for all reasons were very small. The testimony showed that appellant sought to improve its product, not that its product was not acceptable. The Finding is also improper in that it is indefinite since the words "unqualifiedly commercially acceptable frames" are vague and have no antecedent in the patent law, either statutory or case.

16. The court erred in making Finding of Fact No. 48 (R. pp. 52-53) because it is contrary to the weight of the evidence which established that appellant discontinued the use of a mixture of polystyrene and Darex Copolymer No. 3 not because it was commercially unsatisfactory but because a completely mixed molding powder was available which was much more economical for appellant to use.

17. The court erred in making Finding of Fact No. 49 (R. p. 53) because this Finding is contrary to the weight of the evidence which established that the co-

polymer used to modify polystyrene in Bakelite TMD 2155 employed by appellant for a time has a high styrene content. The reason for this is given under paragraph 14 hereof.

18. The court erred in making Finding of Fact No. 50 (R. p. 53) because this Finding is contrary to the weight of the evidence which established that the copolymer used to modify polystyrene in the Monsanto Chemical Company Lustrex Hi-Test 89 employed by appellant for a time has a high styrene content. The reason for this is given under paragraph 14 hereof.

19. The court erred in making Finding of Fact No. 51 (R. pp. 53-54) because this Finding is misleading and unsupported by the evidence. The testimony established that appellant's frames achieved commercial success from the beginning and that its difficulty was not at all in producing an acceptable and satisfactory frame but in the obtaining of a conveniently located firm to mix the raw materials of its molding powder. The Finding is also wrong in the statement that appellant's successful frames were made of polystyrene modified by a copolymer having a low styrene content, for the reasons set forth previously under paragraph 14 hereof.

20. The court erred in making Finding of Fact No. 51a (R. p. 54) because the original frames produced by appellant with its original formula were clearly shown to have utility. The Finding is also wrong in the statement that the copolymer used to modify polystyrene in the accused (appellee's) frames has a low styrene content, the reasons for this having been set forth already under paragraph 14 hereof.

21. The court erred in making Finding of Fact No. 52 (R. p. 54) for the following reasons: First of all, even if the materials used by appellant in making its frames were well known in the art, this would be irrelevant to the issue of validity herein since the invention of the suit patent lies in the making of a battery hold-down frame of a particular type of plastic. Secondly,

said materials were not shown to be old. Thirdly, under the circumstances of the present case there was invention in making a battery hold-down frame of a particular type of plastic; and fourthly, the use of plastic for a battery hold-down frame was not disclosed by Leuvelink, U. S. Patent No. 2,382,428, dated August 14, 1945, prior to Coleman as stated in the Finding; Leuvelink's patent relates to a clamp for an electron tube and discloses the use of a plastic wholly unsuitable for a battery hold-down frame, as found by the Board of Appeals in the Patent Office.

22. The court erred in making Finding of Fact No. 53 (R. pp. 54-55) because said Finding is vague, indefinite and irrelevant. Durability is not at all the only necessary characteristic of a plastic battery hold-down frame, so the fact that plastics might previously have been used for durable articles is of no significance. Many durable plastics are utterly unsuitable as materials for battery hold-down frames. Also, the Finding is entirely unsupported by the evidence which did not establish that any article "such as a frame" was made of plastic prior to the invention of the suit patent.

23. The court erred in making Conclusion of Law No. 7 (R. p. 55) because the conclusion that the suit patent lacks utility and does not disclose and claim a patentable invention is unsupported by the facts, and so is the conclusion that the patent is, therefore, invalid.

24. The court erred in making Conclusion of Law No. 8 (R. pp. 55-56) because the conclusion that the patent is indefinite is not supported by the evidence inasmuch as the patent does teach one skilled in the art how to achieve a plastic battery hold-down frame having the requisite physical and mechanical properties by using the type of plastic disclosed and the claims also point all this out. Moreover, even if some experimentation were required by one skilled in the art to achieve a frame having the requisite characteristics this would not render the patent invalid since there is

no law to the effect that a patent disclosure must be so exact that no experimentation whatsoever would be required in duplicating the invention. Finally, exact proportions as stated in this Conclusion are not required to obtain a frame having the requisite mechanical and physical characteristics so long as the basic disclosure of the suit patent is followed. The conclusion that the suit patent is invalid in its entirety is wrong for the foregoing reasons.

25. The court erred in making Conclusion of Law No. 9 (R. p. 56) since the suit patent does disclose invention over the prior art and is valid, and the subject matter of the suit patent was not stated in any printed publications published more than one year prior to the date of application for the suit patent.

26. The court erred in making Conclusion of Law No. 10 (R. p. 56) since this conclusion of non-infringement is based on the erroneous conclusion that the patent is invalid.

27. The court erred in making Conclusion of Law No. 11 (R. p. 56) because the accused frames do infringe the suit patent inasmuch as the copolymer employed therein to modify the polystyrene thereof has a high styrene content and not a low one or is the equivalent of a copolymer having a high styrene content. Also, Conclusion No. 11 is contrary to the evidence.

28. The court erred in making Conclusion of Law No. 13 (R. pp. 56-57) because appellee was not entitled to judgment on its counterclaim for declaratory judgment. The suit patent and the claims thereof are valid, and the accused frames do infringe the claims of the suit patent.

29. The court erred in admitting in evidence U. S. Patent No. 2,578,518, dated December 11, 1951 to Ditz, *et al.*, this being Def's Ex. A. The objection to the admission of this patent occurs at R. p. 296 and reads as follows:

"The Court: What is your objection, then?"

Mr. Kirschstein: The patent issued after the filing date of the suit patent. I believe that it is only admissible on the issue of prior invention; not on any other issue.

Mr. Caughey: It is not a publication, sir.

The full colloquy concerning Def's Ex. A including the court's ruling upon the objection and a statement of the purposes for which appellee offered the exhibit occurs at R. pp. 295-298.

The Ditz, *et al.* patent relates to battery containers and the molding thereof from polystyrene modified by various copolymers of butadiene and styrene.

The reason why the Ditz *et al.* patent should not have been admitted in evidence as prior art is that it bears an issue date later than the filing date of the suit patent. Under the law such a patent can only serve to show that the inventor of the suit patent was not the first inventor. Since the Ditz *et al.* patent does not relate to plastic battery hold-down frames, it could not possibly show even that the inventor of the suit patent was not the first inventor of the subject matter thereof and could not properly be admitted for that purpose either.

30. The court erred in basing any of its findings, holdings or conclusions on the Ditz *et al.* patent which for the reasons set forth in paragraph 29 hereof was improperly admitted in evidence.

II.

Regarding the unfair competition count, the appellant relies on the following errors:

1. The court erred in making Finding of Fact No. 7 (R. p. 42) to the effect that the legends and symbols on appellant's cartons for its battery hold-down frames and appellee's cartons are different. Said legends and symbols are different in some respects but are substantially the same in form, language and color scheme.

2. The court erred in making Finding of Fact No. 9 (R. p. 42). There was evidence of imitation and deception tending to mislead the section of the public constituting the automotive trade as to source and sponsorship of the goods of the parties. The fact that the accused frames deliberately simulate appellant's frames in non-functional color and shape despite the conceded availability of other colors was clear evidence of intent to deceive, and this evidence was supported by uncontradicted testimony that appellant's frames have long and frequently been displayed out of their containers in gas stations and automotive stores.

3. The court erred in making Finding of Fact No. 10 (R. p. 42) to the effect that all of the elements and features of the appellant's and appellee's frames are functional. There was no evidence whatsoever that the color and shape of the frames are functional; in fact appellee itself introduced in evidence a metal frame coated with plastic and capable of performing the same functions as the accused frames but having an entirely different shape and appearance.

4. The court erred in making Finding of Fact No. 11 (R. p. 42) to the effect that there is no evidence of actual confusion or tendency to confuse. There was such evidence.

5. The court erred in making Finding of Fact No. 13 (R. p. 43). The statement that nothing in the record indicates that the color red of appellant's frames had acquired secondary meaning is contrary to the weight of the evidence. There was testimony of independent, unbiased witnesses to the effect that the color red had become known as identifying appellant's frames which were asked for as the "red frames."

6. The court erred in making Conclusion of Law No. 2 (R. p. 55) because the conclusion that there was no evidence to sustain appellant's claim for unfair competition was completely contrary to the weight of the evidence.

7. The court erred in making Conclusion of Law No. 3 (R. p. 55) because the evidence clearly established that the accused frames are sold in unfair competition with appellant's frames.

8. The court erred in making Conclusion of Law No. 4 (R. p. 55) because appellant established clearly its exclusive right to the color red for a battery hold-down frame.

9. The court erred in making Conclusion of Law No. 5 (R. p. 55) because appellant established its exclusive right to the design of its hold-down frame which design is non-functional.

10. The court erred in making Conclusion of Law No. 6 (R. p. 55) because the appellant was entitled to relief for unfair competition since it established secondary meaning, deception and likelihood of confusion between its frames and appellee's.

11. The court erred in making Conclusion of Law No. 12 (R. p. 56) because the complaint should have been sustained as to both counts thereof.

12. The court erred in making Conclusion of Law No. 14 (R. p. 57) insofar as it stated that appellee was to be awarded costs; the complaint should have been sustained and appellant awarded costs.

III.

As to the counterclaim, the court erred in failing to find and conclude that the suit patent is valid and infringed and that therefore the counterclaim should be dismissed.

THE PATENT INFRINGEMENT COUNT

Introduction and Summary

A battery hold-down frame is a device employed in automobiles and other vehicles such, for example, as tractors, to hold the storage battery in place. It is fitted over the top of the battery container and bolted to the car, the battery being retained in place by the clamping action of the hold-down frame. Prior to the present invention (around the beginning of 1951), only metal hold-down frames had been employed from the time the storage battery came into use on automobiles in about 1914.

The metal battery hold-down frames were subject to many drawbacks both from the point of view of having an adverse effect on the storage battery and even on the car itself. Basically, their electrical conductivity and their corrodibility made them dangerous and difficult to use. Their only advantage was cheapness. The patentee overcame the problems presented by metal frames (which will be dealt with in much greater detail hereinafter) by inventing a plastic battery hold-down frame having none of the defects of the metal frame.

The plastic frames have been commercially successful and have displaced the metal hold-down frames to a very great extent as far as the sales of hold-down frames for replacement purposes (as opposed to original equipment purposes) are concerned.

The patent in suit discloses a plastic battery hold-down frame having certain physical characteristics whereby it can exert force against the top of a storage battery and thereby hold the battery to the car frame, and the patent further discloses that the frame is to be made of a particular type of plastic, to wit: polystyrene, whose physical and mechanical characteristics are modified along certain specific, necessary and desired lines by the addition of a

copolymer of butadiene and styrene having a high styrene content. The patent sets forth the defects of metal frames and the particular physical and mechanical characteristics necessary for plastic battery hold-down frames if they are to be a successful and acceptable product. All of this will be discussed in greater detail hereinafter.

Appellee raised the usual defenses of invalidity and non-infringement, the former being predicated mainly on prior art and alleged indefiniteness of the disclosure of the suit patent. The claim of non-infringement was based on the theory that the copolymer employed to modify polystyrene in the composition of appellee's hold-down frames is not a butadiene-styrene copolymer having a high styrene content.

Despite clear proof that the patented frames filled a long-felt need in the trade, that they had great commercial success, that the prior art did not show anything like the invention, and that the patent has a sufficiently definite disclosure, the lower court held claim 3, the only claim in suit, invalid. In addition, the trial court held that the patent was not infringed despite proof that the accused frames come within the mechanical and compositional limitations of claim 3 or employ an equivalent as far as composition is concerned.

Butadiene-styrene copolymers are known as "Buna S's." The butadiene-styrene copolymer having a 25% styrene content is the standard all-purpose synthetic substitute for rubber; it is known as standard G. R. S. (meaning Government Rubber Styrene).

It should be clearly borne in mind that the frames of both parties are not made of *polystyrene alone* or of a *Buna S alone*; they are made of a plastic predominantly polystyrene but modified by a Buna S having a styrene content higher than that of the standard Buna S.*

* The trial court repeatedly indicated in its opinion a confusion as to what in fact the plastic frames of the parties were made of. Most of the time the court appeared to be under the impression that the frames were made

It is to be emphasized at the outset that the present case is not one where an inventor merely took an old object and used a new material for the purpose of making it in order to impart superior characteristics thereto. The individual raw materials for the patentee's plastic battery hold-down frames were old and had long been available. Yet, despite the need for far better frames than the old metal ones, no one thought of making this part of automobile equipment out of plastic and no one thought of modifying polystyrene with a high styrene butadiene-styrene copolymer to provide a material for such a frame. Butadiene-styrene copolymers with styrene contents as high as that in the modifying copolymer employed in the plastic of appellee's frames were known as far back as 1944,* although appellee's specific modifying copolymer was not developed till later; and, of course, polystyrene is one of the oldest plastics known.

How the Invention Was Made

The inventor, Sidney Coleman, at the time he conceived the invention of the suit patent, had been for many years a salesman in the automotive field (R. p. 389). He was familiar with the difficulties with the old metal frames (R. pp. 391-392) and in the early part of 1950 conceived the idea of obviating them by making the frames of plastic (R. p. 389). The idea of making frames of plastic was an entirely new concept in the automotive trade and no one had done anything like it before. This is shown irrefutably by the fact that plastic frames solved the problems en-

solely of the modifying butadiene styrene copolymer itself (R. p. 20). At another point the court indicated that it thought the frames were made of butadiene and polystyrene (R. p. 35). This confusion as to nomenclature, it is believed, militated against a full understanding below of the invention itself, particularly in the light of the fact that the Court did not have the benefit of a transcript of the testimony nor did it request briefs after trial.

* See Plaintiff's Ex. No. 69 at R. p. 465, No. 70 at R. p. 467, and No. 71 at R. p. 469.

countered with metal frames and these problems had plagued the industry for upwards of forty years.

Having conceived the idea of making plastic battery hold-down frames, there remained for Mr. Coleman to find a type of plastic that would be suitable for them. There was no precedent for using any particular type of plastic since there had been no plastic battery hold-down frames at all prior to the invention. Moreover, other articles in the automotive trade made of plastic such as battery casings themselves did not have the same physical requirements at all as the frames. Plastic battery hold-down frames, as set forth in the suit patent, firstly had to have sufficient flexibility so that they would not break the battery casings when used to maintain a battery in place (a characteristic not required by the battery casings themselves which merely need to be sufficiently unbrittle so that they will not break due to the bumping of the car in which the battery is located). Secondly, a plastic frame had to be able itself to survive the impacts involved in driving a vehicle; further it had to be impervious to, i.e., not corrode when subjected to, the chemicals of the battery, water and air. And, in addition, a plastic frame had to be a non-conductor of electricity and had to be able to withstand the high temperatures existing near the motor of the car (Suit patent, Col. 1, lines 20-52 and Col. 2, line 40 to Col. 3, line 2; R. pp. 392-393).

Coleman experimented with several plastics which were readily available to him, these being polystyrene and polyethylene, but polystyrene was too brittle and polyethylene too flexible (R. pp. 367, 390). The way in which Coleman finally arrived at a plastic to satisfy his purposes is both interesting and significant from the point of view of invention. He realized that polystyrene was a good basic material because it is not subject to corrosion and is not a conductor of electricity; however, its melting point is too low to withstand the temperatures near the motor of

a car, and it has insufficient strength, toughness and flexibility to be used for the desired purposes (Suit patent, Col. 2, lines 42-52). While mulling over the problem of how to modify the polystyrene, Coleman came across a cigarette case made of a flexible plastic. Upon examining it and testing it by burning and smelling the smoke given off (a common layman's test), he recognized that the material was a rubbery type of substance and it occurred to him that by adding some of it to polystyrene he might be able to modify the polystyrene so as to obtain a plastic meeting the requirements he conceived to be necessary (R. pp. 366-367, 394).

Having in mind that polystyrene was to be his basic material but that it had to be modified in certain respects, Coleman obtained some of the molding powder from which the cigarette case had been made and tried molding battery hold-down frames from polystyrene to which the material of the cigarette case (which material came in powder form) had been added; he found that when sufficient material was added to modify the polystyrene, a plastic frame meeting all of his requirements could be produced (R. pp. 367-369). Later, he ascertained that his modifying material, which was a product known as "Darex Copolymer No. 3" manufactured by the Dewey and Almy Chemical Company of Cambridge, Massachusetts, was a copolymer of styrene and butadiene with a high styrene content and that such copolymers were generally known as Buna S's with a high styrene content (R. p. 397). Coleman's reduction of his invention to practice as aforesaid occurred in January or February, 1951 (R. pp. 394, 397-398).

The polystyrene and modifying copolymer employed in the patented frames are *not* interpolymerized with one another or otherwise chemically combined; they are physically mixed. Of course, the making of polystyrene itself involves polymerization of styrene, and the making of a Buna S involves copolymerizing butadiene with styrene. But the polystyrene and copolymer molding powder

employed in making the battery hold-down frames is a physical mixture of the two separate powders, not a chemical compound of them.

It is to be emphasized that Coleman does not claim to have originated either battery hold-down frames or a new plastic. What he did invent and does claim is a plastic battery hold-down frame made of a particular type of plastic material suitable for his purposes. The invention thus has the dual aspect of the conception of the idea of making the frames from a plastic material, the recognition of the requirements for the plastic material, and the provision of a particular type of plastic suitable for the purpose.

The Disclosure of the Suit Patent

The suit patent sets forth, first of all, the defects of the old metal battery hold-down frames. Among these defects are the fact that said frames are corrodible and, therefore, subject to attack by the electrolyte of the battery, are electrically conductive, tend to crack the top of the battery because of the frame's lack of resiliency, and adhere to the battery due to corrosion (Suit patent, Col. 1, lines 20-52).

The suit patent discloses that the defects of the metal frames can be overcome by making the frames of plastic but that to do this certain requirements have to be met, to wit, the frames must be non-conductive, non-corrodible and have sufficient elasticity, heat resistance, building strength and toughness (Suit patent, Col. 1, line 72 to Col. 2, line 4; Col. 1, lines 20-52; Col. 2, lines 62-68).

Coming now more specifically to the disclosure, the invented frame is described as being a one-piece rectangular shaped article including two parallel sides connected by two parallel ends. Said sides and ends are recited as being adapted to abut against the outer faces of the sides and

ends of the battery casing. The frame also includes elements adapted to bear against the top of the battery casing, these elements constituting the inner corners of the frame. Openings for bolts are provided either at the ends or along the sides of the frames. The frames are of such size as to be adapted to fit the particular battery casing with which they are to be used (Suit patent, Col. 2, lines 18-39). The plastic of which the frame is made is described in the patent as being a modified polystyrene and more specifically as being polystyrene modified with a Buna S having a high styrene content (Suit patent, Col. 1, line 72 to Col. 2, line 4; Col. 2, lines 40-41, 51-56; and Col. 2, line 71 to Col. 3, line 2).

Inasmuch as will be pointed out in greater detail hereinafter the trial court was mistaken as to the nature of the invention,* it is important to emphasize that the patent discloses an article made of a particular type of material. *It does not purport to be a chemical patent or to disclose a new plastic or formulation or chemical combination of some kind.* The invention was to make a battery hold-down of plastic from a type of plastic which would have the proper characteristics for a hold-down frame. Accordingly, the claims in suit describe the article as to its mechanical elements, recite that it is to be made of plastic, recite that the type of plastic is to be polystyrene modified with a Buna S having a high styrene content, and recite the physical and mechanical characteristics which the plastic must have. In other words, the newly invented frame had to be claimed both in the terms of its mechanical aspects and in terms of the composition of which it is made and the physical characteristics imparted by the composition to the article. This is entirely permissible in patent law as the cases cited *infra*, p. 56, hold.

Claim 3 was the only claim relied on at the trial and in order for the court to better understand the nature of the present case, it is set forth in full:

* The Court considered it to relate to a chemical combination.

“3. A one-piece open battery hold-down frame formed of plastic material and including elements bearing against the sides and top of the battery, the plastic material of which said frame is formed comprising polystyrene, the mechanical and physical properties of which have been modified by the addition of a Buna S with a high styrene content, the latter imparting to the polystyrene improved heat resistance, building strength and toughness sufficient to withstand pressure to which the frame is subjected in its function to hold the battery on its support, and also imparting to the polystyrene enough flexibility to prevent breakage of the battery top against which elements of said frame bear in the holding down operation.”

It will be noted that neither claim 3 nor any claim of the patent nor the disclosure of the patent sets forth precise amounts or proportions for the mixture of polystyrene and the Buna S having a high styrene content. The reason for this is that, as mentioned above, the patent is not for a chemical composition nor is it for a plastic frame made of any specific precise composition. The claim and specification do specifically set forth, however, not only the particular type of plastic which will be satisfactory and what it is composed of, but also the very physical and mechanical requirements which the plastic must have, (in addition, of course, to the purely mechanical aspects of the invention). This will be shown to be sufficient compliance with the patent law in view of the fact that the invention is of a battery hold-down frame made of a particular, suitable type of plastic.

Argument—Validity

POINT I

Appellant established a long felt unsatisfied need which was filled by the invention of the suit patent.

It is axiomatic in patent law that one of the most compelling criteria of invention is that a long felt unsatisfied need existed in the field to which the patent relates and that the need was satisfied by the invention. Sometimes the matter is stated in terms of a long unsolved problem overcome by the invention (see cases cited *infra*, pp. 45-46). In the present case the existence of a long felt unsatisfied need and of a problem in the automotive industry was established beyond any doubt; indeed, it was even conceded by appellee (R. p. 67).

Appellant's witness Samuel Ert was a man with almost fifty years experience in the automotive trade, and in particular his experience related to automobile storage batteries (R. pp. 63-64). His unchallenged and unbiased testimony, for he was a completely independent witness, was supported by exhibits brought by him to court from his own shop. Mr. Ert's testimony established that the metal hold-down frames previously employed to hold car batteries in place until the advent of the invention of the suit patent had been subject to many serious disadvantages known to the trade from the time storage batteries were first employed on cars, almost forty years ago (R. pp. 64-69). More specifically, Mr. Ert testified, in this respect corroborating the statements made in the suit patent, that the metal hold-down frames are highly subject to corrosion from the battery acid and that because they are electrically conductive there is great danger of short-circuiting which can cause a fire (R. pp. 64-69). He stated that the action of acid fumes on the metal frames causes them to corrode and presented exhibits corroborating this (R. pp. 64-65; Pl's Ex. Nos. 56-

58). In addition, he brought to court frames taken from cars in which fires had been caused by short-circuiting (Pl's Ex. Nos. 54 and 55). Ert's testimony established that the corrosion and short circuit problems were very serious ones because due to corrosion there is leakage of battery acid whereby the battery is weakened and due to the short circuiting the battery may be ruined or destroyed by fire or even the car itself set on fire.

Mr. Ert testified further that appellant's plastic hold-down frames, embodying the invention of the suit patent, solved the problems that had been in existence for over forty years with the metal frames because the plastic frames would not corrode so that they could continue to protect the battery and that they could not cause any fire or short circuit of the battery (R. pp. 69-72). He stated that the market for metal frames as replacements for the original equipment on cars has greatly decreased since appellant's plastic frames came on the market because of the superiority of the latter (R. pp. 71-74).

Corroborative of the testimony of Mr. Ert was the testimony of Morton Bean of Quality Electric Products of New York City, New York, a man thoroughly experienced with and familiar with the automotive trade and battery hold-down frames (R. pp. 98-99). Mr. Bean, backing up statements made in the suit patent, testified that not only do the electrically conductive metal frames corrode but that after they have corroded to some extent they cause a drop in the battery amperage because of their electrical conductivity (R. p. 100). Additionally, he pointed out that improperly installed metal frames break the tops of the battery cases which are made of a plastic material not nearly as strong and hard as metal (R. p. 100). As was the case with Mr. Ert, Mr. Bean had personal knowledge of these defects (R. p. 101).

Bean testified that when the appellant's plastic battery hold-down frames were put on the market, there was an

immediate favorable response to them and they were a big success because they were so much better than the metal hold-down frames. Further, Bean stated that in about three years his firm sold approximately 200,000 of appellant's frames and that the demand for metal frames became nil with the advent of the plastic frames; indeed, one company which had made metal frames even went out of business after the plastic frames came into use (R. pp. 101-102, 104-105).

The witness Abraham Golden of Mitchell Auto and Tire and London Supply Company, New York City, New York, testified to substantially the same matters as Bean. He corroborated Bean's testimony regarding danger of short circuit and corrosion with the metal frames and the fact that the plastic frames have replaced the metal ones because they solved the problems present for so long with metal frames. He also stated that his concern sold about 12,000 plastic frames a year and that the sales in the metal frames have declined greatly (R. pp. 114-126).

It is believed that appellant established clearly beyond any question that the invention of the suit patent solved a long existing problem of great significance to the automobile industry and filled a long felt need.

POINT II

The invention has been a commercial success.

The appellant as assignee of the patented invention pioneered the use of plastic battery hold-down frames in the automotive industry, introducing them in June, 1951. Appellant's frames from the very beginning had great utility, and appellant was able to establish to the trade that it not only had an acceptable article but a highly superior one which actually eliminated problems that had plagued the trade for many, many years. Beginning in 1954, appellant's plastic battery hold-down frames caught

on rapidly and sales thereof soared (R. p. 256). And for the last three or four years prior to the trial appellant's business in plastic battery hold-down frames has been a very large and lucrative one and sales of metal hold-down frames have sharply diminished (R. pp. 252-256; Pl's Ex. No. 30 at R. p. 460).

A circumstance that gave impetus to the sales of appellant's plastic frames was the coming into use of 12-volt storage batteries in cars. (The previous standard battery was 6 volts.) Such batteries with their extra high voltage arced seriously because of the conductivity of the metal hold-down frames. Arcing is a phenomenon which occurs when the electric current jumps from one electrode of a battery to the other and is in essence an intermittent short-circuit. Many 12-volt batteries burned out in short periods of time and were fire hazards due to arcing; and appellant's plastic frames which prevented the arcing therefore increased greatly in popularity.

From 1951 to the date of the trial, appellant sold over one and a half million dollars worth of plastic frames, though its advertising expense in all that time was not more than \$6,000.00 (R. pp. 259-260). The sales mentioned represent over three million frames sold in about a period of six years, and this figure assumes even greater significance when it is recognized that the frames primarily are sold for replacement and not as original equipment on cars (R. pp. 252-256; Pl's Ex. No. 30).

Appellant's plastic battery hold-down frames have always been manufactured in accordance with the suit patent (R. pp. 213-217; Stip., Pl's Ex. No. 63 at R. pp. 461-464).

POINT III

The invention of the suit patent has utility.

On the question of utility, appellee seized upon certain remarks made by the inventor and by Erich Fritsch, Vice-President of the appellant, in the course of their depositions, and by reading in evidence portions of these depositions in a way such that these remarks came before the trial court out of context and in a misleading fashion, appellee succeeded in misleading the trial court into believing that appellant's original frames were not satisfactory and were unsuccessful because of breakage. This is not so as quotations from the record below will clearly show.

The answer to the claim of lack of utility is two-fold. First of all, appellant sold approximately 32,000 frames totalling \$16,339.35 in dollar volume during the very first year that the product was on the market (R. pp. 416-418; Pl's Ex. No. 30). Appellant's records showed that during that year a total of \$470.60 worth of plastic frames, forks and knives were returned for any reason; obviously, therefore, the returns of frames for defectiveness were negligible compared to sales volume thereof (R. p. 417). The frames sold during the first year were made of appellant's very first composition (R. pp. 415-417).

Secondly, appellant proved that it bought 5,000 pounds of (2½ tons) of Darex Copolymer No. 3, the modifying copolymer first used, from the Dewey and Almy Chemical Company (Pl's Ex. No. 86 at R. pp. 497-500, 503-507). Said material was all used in making the first production of the aforesaid frames very few of which were returned (R. pp. 415-417; Pl's Ex. No. 30). These two points in addition to other testimony clearly refute the claim of lack of utility.

To go into the matter in somewhat more detail, plaintiff encountered at the beginning of its manufacture a practical problem of having the molding powder made. There was

nothing wrong with the formulation; it was simply that to produce a molding powder comprising polystyrene modified with Buna S having a high styrene content, a physical mixture of the polystyrene and the modified substance had to be made (R. pp. 347-348). The Dewey and Almy Chemical Company had no problem doing this but declined to do it on a large enough scale for appellant (R. pp. 357, 375). The Stedfast Rubber Company also had no trouble performing this mixing but was located at a distance of at least 40 miles from appellant so that it was economically impractical to use this company to perform the mixing (R. pp. 356-357). Accordingly, appellant sought to have the Marine Plastics Company which was right in the town of Clinton, Mass. where appellant was located do the mixing; unfortunately this company did not always do it properly. As a result, some frames were defective, and appellant went to an already mixed powder which had subsequent to the invention become available from the Bakelite Company and then from the Monsanto Chemical Company, so that it could save itself the time and expense of buying the components of its composition separately and then having them physically mixed (R. pp. 349, 376).

That the trial court was misled as to the present point is shown by its statement in its opinion (R. p. 30) that appellant switched to compounds made by Dow Chemical Company and the Monsanto Chemical Company having modifying copolymers with styrene contents as high as 80%. There is no evidence that appellant switched to any molding powder made by Dow Chemical Company (Stip., Pl's Ex. No. 63), and certainly it did not switch to one made by anyone in which the modifying copolymer had a styrene content of 80%. The Monsanto material employs a modifying copolymer having a styrene content of 40-50% (Stip., Pl's Ex. No. 63). The Judge did not recall accurately the evidence on this point, and he did not have the benefit of a record or briefs after trial to aid his recollection.

Because appellee managed to obscure this relatively simple point regarding utility, there are quoted below* pertinent parts of the testimony clearly establishing the foregoing facts, and for the documentary proof bearing this out the Court is respectfully urged to examine Plaintiff's Exhibits Nos. 30 and 86.

* "Q. Did Dewey & Almy mix a complete molding powder for you at that time? A. Yes.

Q. Including polystyrene? A. Yes.

* * * * *

Q. Was that material satisfactory? A. Yes.

Q. Do you know what was in it? A. Yes.

Q. What? A. Well, I don't know whether I—

There was Darex copolymer 3, polystyrene, a clay, and a small amount of wax for lubricating purposes, just for the molding purposes, not in any way affecting the properties of the compound' " (R. p. 353).

"Q. * * * I am asking you whether your company was still looking for materials for the battery hold-down frame? A. No, sir. We felt we had an excellent product, as I remember, from the materials that were made from the processing mixture made for us by Dewey & Almy Company (R. p. 357).

Q. Was the plastic battery hold-down made with polystyrene and the Darex Copolymer No. 3 a good commercial product? A. Yes.

Q. Was there any difficulty with it, other than the problem of getting the proper chemical means of getting it mixed? A. We had no problems when Dewey and Almy made the first material. We had no problems when Stedfast Rubber made the compound for us. We experienced problems during the time Marine Plastics did the compounding.

Q. You testified about the selection of materials from Bakelite and Monsanto. Am I correct in stating that that was concerned with the question of production after you had a commercial frame on the market for some time? (R. p. 357)

* * * * *

A. Yes' " (R. p. 358).

"Q. What did you find was unsatisfactory with them [the plastic frames]? A. It was an acceptable item, however it could stand improvement. We changed the structure, made certain parts stronger (R. pp. 408-409).

Q. Did you receive returns of battery hold-down frames during the period, 1952? A. I don't think so.

Q. No frames were returned? A. I don't know of any.

Q. You don't know of any frame being returned because it was unsatisfactory? A. I, myself, don't know of that.

Q. Who would know that? A. I think we'd have to check if there's any returns in the accounts receivable or Mr. Coleman would know. Let

POINT IV

The prior art does not show lack of invention in the suit patent.

None of the patents or publications cited by appellee shows a plastic battery hold-down frame. Of this there can be no question; and, indeed, no contention was made at the trial that any such art existed. The trial court's holding of invalidity of the suit patent was predicated on the theory that since battery hold-down frames *per se* as a physical object made of metal were old, invention would only be present if the plastic disclosed were itself new. The court treated the suit patent as a chemical patent for a combination of substances and held that because certain publications and the patent to Ditz *et al.* supposedly showed plastics comprising polystyrene modified with a Buna S having a high styrene content there could be no invention in the suit patent.

It is respectfully submitted that the position taken by the trial court entirely misses the point of the invention. The invention is not of a chemical combination but of a specific article of manufacture made of a certain type of material. Appellant does not concede that the type of plastic disclosed in the suit patent was shown in any properly admitted prior art, as will be pointed out hereinafter, but even if it were, there would still be invention because what the patentee did was not only new but it

me modify that in one way. If an account went out of business and merchandise was returned, certainly, there must have been a refusal, but I, myself, don't know of any specific return.

Q. Mr. Coleman would be the man to know if there were any returns because the material was unsatisfactory? A. I imagine so. I don't recall of any complaint from the outside of our material being unsatisfactory' " (R. p. 409).

"Q. And that all of the frames shipped out before then [July 8, 1952] would have been made with the Dewey and Almy copolymer plus the polystyrene. A. Sure.

Q. I refer to Exhibit 31 [Plaintiff's Exhibit No. 30]' " (R. p. 416).

brought about new results whereby an almost 40-year-old problem was solved.

The court's treatment of the suit patent as a chemical patent for a combination was a fundamental error which underlies the holding of invalidity both for lack of invention and lack of sufficient disclosure.

Coming now more specifically to the art relied on by appellee and the lower court, it is conceded that patent Nos. 1,677,789 to Mabey and 2,360,056 to Heitshu show metal battery hold-down frames. Also, there is no question but that the patent to Leuvelink, No. 2,382,428, discloses a plastic clamp for electron tubes. The court's conclusion, however, that it would be obvious to make the metal frames of plastic in view of the Leuvelink patent totally disregards the fact that the plastic of which the clamp in said patent is made is wholly unsuitable for use in a plastic hold-down frame and that the clamp itself in that patent is, of course, an entirely different article from a battery hold-down frame and has different mechanical and physical requirements. As already mentioned, the Board of Appeals in the Patent Office considered and rejected this very contention. Indeed, that tribunal made the following significant remarks in this regard:

"We do not agree with the Examiner that it would be particularly obvious from the disclosure of Leuvelink to select a plastic which would possess the required strength and toughness and still have enough flexibility to prevent breakage of the battery top when the hold-down devices were clamped in position. Leuvelink clearly does not disclose such a plastic and, in fact, would lead one away from the use of a plastic for this purpose since he states that where slight yieldability is desired the clamping element should be formed of molded rubber" (Pl's Ex. No. 2, R. p. 453).

Defendant relied very heavily on the Ditz *et al.* patent, No. 2,578,518 as did the court in its decision. But the

Ditz *et al.* patent like all of the other art cited does not even suggest, much less disclose, the making of a battery hold-down frame from plastic. This patent relates entirely to battery casings and is primarily a chemical patent devoted to the disclosure in a fairly precise and detailed way of a composition that can be used in molding battery containers. Basically, the patent relates to the problems involved in molding 5-sided hollow objects (R. pp. 424-425), and every claim recites a molded battery container. Some of the compositions disclosed can be used in the manufacture of plastic battery hold-down frames within the teaching of the suit patent. But Ditz *et al.* does not disclose such a use even though the inventors were working in the automotive field and even though the patent mentions other uses for the plastic besides battery casings. The lower court in holding in view of Ditz *et al.* that plastic of any type or even the type disclosed by Ditz *et al.* could obviously be used for Coleman's purposes, i.e., to make a hold-down frame, fell into the common error of using hindsight after the event. It took Coleman to teach this use—that is the crucial point. The Ditz *et al.* patent, therefore, does not negative invention in the suit patent any more than the other references cited do.*

Except for the Ditz *et al.* patent, no reference was submitted supporting even the court's holding and finding that the modification of polystyrene with a butadiene-styrene copolymer having a high styrene content was done before Coleman's invention of a battery hold-down frame made of such material. Thus, the 1948 letter from Carl Fox in the December, 1948 "Modern Plastics" (Defendant's Ex. M), relied on by the court, simply says that Darex Copolymer No. X-34 had been used as a plasticizer and extender for polystyrene to give it more impact resistance.

* As mentioned in Specification of Error No. 29 herein, *supra*, pp. 12-13, appellant contends that the Ditz *et al.* patent was inadmissible as a reference because it issued after the filing date of the suit patent. This point and the law applicable thereto will be developed in detail hereinafter, see *infra*, pp. 56-61.

The reference is obviously to experimental work, and the disclosure of this letter is hardly sufficient even to show the prior existence of a modified polystyrene such as that suggested by Coleman, let alone Coleman's use of it. The other reference allegedly supporting the court's holdings and findings regarding the novelty of the plastic itself is "Modern Plastics Encyclopedia" of 1950 (Defendant's Ex. T). Defendant's own expert, Mr. Stringfield, however, admitted on cross-examination that he could not tell from this disclosure whether the Buna S was being modified by polystyrene, i.e., there was less than 50% polystyrene, or whether the polystyrene was being modified by the Buna S, i.e., there was more than 50% polystyrene as required by the suit patent (R. pp. 322-324). And despite the alleged vagueness of the suit patent, even defendant's expert admitted that the reference therein to polystyrene modified by a Buna S having a high styrene content necessarily means that there must be more than 50% polystyrene in the plastic (R. pp. 322-323). Referring further to this reference, although in the case of various other plastics mentioned therein, the uses of the plastics were suggested, this was not the case with respect to the plastic referred to in the paragraph relied on by defendant (R. pp. 321-322). Once again, therefore, not only is the specific plastic set forth in the suit patent not clearly and definitely shown by the cited art, but the use thereof for a hold-down frame which is the heart of the Coleman invention is not even suggested.

To summarize, none of the art cited suggests making a battery hold-down frame of plastic, and the only art even showing the type of plastic mentioned in the suit patent is the improperly admitted Ditz *et al.* patent.

POINT V

The court erred in not holding that the use of a particular type of plastic for a battery hold-down frame was non-analogous.

The court's holdings and findings that invention did not reside in conceiving the use of a particular type of plastic for a hold-down frame and that the use to which Coleman put his recommended plastic was not a non-analogous one, appear to be based on the utterly unsupported holding that "Coleman was not the first to teach the art to use plastics in the manufacture of battery hold-down frames" (R. p. 36). Not even appellee contended that Coleman was not the first to teach this. It is to be repeated and emphasized that no one prior to Coleman suggested making a battery hold-down frame of any plastic whatsoever, and no one suggested making such a frame of polystyrene modified by a Buna S with a high styrene content. The lower court's complete disregard of this fact and its decision that what Coleman had done was obvious, constitute a fundamental error. Moreover, this holding is contrary to the holding of the highly trained experts of the Patent Office Board of Appeals, quoted *supra* at p. 32 hereof.

The reason Coleman did not receive a patent for just plain plastic frames is that all plastics are not satisfactory for his purposes and a patent that broad would have included inoperative articles. The trial judge apparently did not understand this and relied heavily on the fact that claims to plain plastic frames were not allowed. Indeed, the lower court even mistakenly believed that the inventor sought to get the original broad claims after the appeal (R. p. 20). The file wrapper shows that the original claims were cancelled after the appeal (Pl's Ex. No. 2, R. p. 456—"Cancel Claims 1 and 2 and insert the following new claims:"). That the District Court relied on its misconception that the Patent Office refused broad claims be-

cause of lack of invention is also apparent from its opinion wherein this supposed fact is referred to as "very significant" (R. p. 20).

The Ditz *et al.* patent on which defendant placed heaviest reliance relates to battery containers (Ditz *et al.* patent, Col. 1, lines 5-8; and the claims of this patent). The testimony of Mr. Miller clearly showed why use of the plastic disclosed in the Ditz *et al.* patent for battery containers would be wholly non-analogous to use of that same plastic in battery hold-down frames (R. pp. 422-425). The problems of molding a hollow five-sided object are what concerned the Goodrich people when they were working on the subject matter of the Ditz *et al.* patent,* and these problems are entirely different from those encountered with a battery hold-down frame which is to be used to clamp, not merely as a container for liquid. Thus, even though Goodrich makes finished articles in the automotive field and the Ditz *et al.* patent relates to battery containers, this patent does not even suggest making battery hold-down frames of the plastic referred to therein to solve the long-standing problems with metal frames of which Goodrich must surely have been aware. And this is so despite the fact that the patent does mention other uses in addition to use as a battery container (Ditz *et al.* patent, Col. 1, lines 34-36). The court's holding that use of the plastic in Ditz *et al.* for Coleman's purposes is obvious and analogous simply cannot be upheld.

As to whether the recommendation of one type of plastic instead of another for a battery hold-down frame in-

* "It is difficult to remove hollow objects molded of these materials from the mandrel on which they are formed. Furthermore, the finished molded articles exhibit low impact resistance and tend to crack when subjected to changes in temperature.

We have now discovered that compositions comprising a homogeneous mixture of polystyrene with a lesser amount, especially from one-tenth to one-third its weight, of a copolymer of an open-chain conjugated diolefin exhibit unexpectedly superior properties which render them useful for many purposes, particularly in the manufacture of hollow molded articles" (Ditz *et al.* patent, Col. 1, lines 16-29). (Emphasis supplied.)

volved invention, it is respectfully submitted that in view of the fact that no one prior to Coleman had recommended the making of a battery hold-down frame of plastic at all, the recommendation of a specific type of plastic for that purpose did involve invention. The lower court held that plastics were coming more and more into use so that it was inevitable that plastic hold-down frames would be made (R. p. 38). This is purely a subjective holding unsupported by any showing in the record. Appellee did not show in any way that contemporaneously with Coleman's invention plastics were first coming into actual use in the automotive field. The record is absolutely devoid of any such proof. Indeed, Bean testified to the contrary on this point under questioning from appellee's counsel (R. p. 111).

Finally, Coleman made his invention before high impact polystyrene even came into commercial use as is shown by the testimony of Mr. Miller (R. pp. 419-422) and Plaintiff's Exhibits Nos. 82, 83, 84 and 85 (at R. pp. 480-493) establishing that the term "high impact styrene" did not make its way into the authoritative plastics publication, *Modern Plastics Encyclopedia*, until 1952, two years after Coleman's invention. There was no revolution in the automotive trade at the time of the Coleman invention whereby all of a sudden the trade turned to plastic materials. Many automotive accessories including those presented by appellee itself constituting Defendant's Exhibit E were and are made of plastics both before and after the Coleman invention. Indeed some of these are flexible or do not even include polystyrene at all and thus have no bearing at all on Coleman's problem. According to appellee's own contention, the individual raw materials for Coleman's plastic frames were available before his invention. Nevertheless, he was the first to solve an old problem; what he did was not obvious, apparently, until after he did it.

POINT VI

The suit patent has a sufficient disclosure.

The court's attack on the disclosure of the suit patent is based on the aforementioned basic misconception that the suit patent is a chemical patent. Moreover, the court erroneously treated the suit patent as a combination patent for a specific plastic material which it definitely is not. If the suit patent were in fact a chemical patent, if it related specifically to new plastics, if the patent purported to cover a combination of chemicals instead of a single article or if it purported to cover broadly all of the plastics which could be used in making a plastic battery hold-down frame, the attack on the disclosure might have some semblance of plausibility. Concededly the suit patent does not precisely give the proportions in which polystyrene and a modified Buna S having a high styrene content should be mixed or state exactly how to mix them, although the disclosure clearly indicates that polystyrene must be present in an amount of at least 50% because the material is referred to as modified polystyrene; nor does the patent disclose molding temperatures, pressures and the like for use of the mixture. But it was not necessary for such a disclosure to be made because the basic invention of the suit patent was the making of a battery hold-down frame of a specific type of plastic and the patent clearly discloses what that material is and the claims are limited to frames made of it. That the recited modified polystyrene will serve the patentee's purposes cannot be denied, and the mere fact that certain proportions of the modifying substance with respect to polystyrene may produce slightly better results than other proportions does not mean that the patent does not clearly disclose, and recite in the claims, what the plastic is of which the patentee desires to make his frames.

Moreover, a detailed and precise disclosure of the method for physically mixing the two plastic powders involved in

making the modified polystyrene is not required in the present case, nor is a detailed description of the molding process itself necessary. No invention is claimed in the physical mixing or in the molding process all of which were simply a matter of conventional techniques in the trade as testified to by Mr. Miller (R. pp. 427-428).

The only question of pertinence on the present point is whether the disclosure of the suit patent is sufficient to teach someone in the art how to make the frames. On this the testimony of appellant's expert, Mr. Miller, is conclusive. Mr. Miller is a man of vast experience in the plastics field and is thoroughly familiar with molding techniques and the like (Miller's qualifications are set forth at length at R. pp. 182-187). He testified that given the disclosure of the suit patent he would have no trouble at all in arriving at a formulation having the requisite characteristics. More specifically, he testified that given the knowledge that the plastic was to be a modified polystyrene as disclosed by the suit patent, at least 50% of the formulation would have to be polystyrene (appellee's expert conceded this, R. p. 323), and given the fact as disclosed by the suit patent that the polystyrene had to be modified so as to acquire certain specified physical and mechanical characteristics he would be able easily to arrive at a satisfactory formulation and would, therefore, be able to immediately produce a satisfactory frame although a little experimentation might be needed to make the very best results (R. pp. 427-428).

It certainly has never been held that a patent must enable a person desirous of practicing the invention thereof to achieve without any experimentation whatsoever the best possible result. Indeed, the law is to the contrary; a reasonable amount of experimentation is to be expected (see cases cited *infra*, pp. 53-55).

Regarding the question of what a Buna S with a high styrene content is, Mr. Miller testified that as a man skilled

in the art he would know that this meant a copolymer of styrene and butadiene having a substantially higher styrene content than that of the ordinary standard copolymer which is approximately 25% styrene (R. pp. 205-206). He substantiated this opinion which was based on long experience by reference to several authoritative and standard government publications clearly reciting that a copolymer with 25% styrene was the standard Buna S (R. pp. 193-195, 198-200, 204; Pl's Ex. Nos. 69, 70, 71 and 72 at R. pp. 465-475), thus making it clear that those copolymers having less than 25% styrene are low styrene content copolymers, and those having amounts substantially higher than 25% styrene are high styrene content copolymers. In particular, he supported his opinion by reference to "The Vanderbilt Rubber Handbook," 9th ed. 1948 (Pl's Ex. No. 69 at R. p. 465) which actually refers to Buna S's having styrene content higher than 25% as "Higher Styrene" copolymers and the 25% styrene copolymer as "GR-S Standard."

Appellee's contention regarding the alleged indefiniteness of the term Buna S having a high styrene content is refuted by the fact that its own expert Mr. Stringfield knew what the term meant. Of course, the meaning attributed to the phrase by him was favorable to appellee and contrary to Mr. Miller's opinion, but certainly the phrase had meaning to both Mr. Miller and Mr. Stringfield, and as will be pointed out in the section of this brief devoted to the question of infringement (*infra*, pp. 64-73), it does not actually matter which interpretation is taken because either way the patent must be held to be infringed. As a matter of fact, Messrs. Kraver and Fritzhand of appellee's supplier and molder of frames purported to understand the disclosure of the suit patent since they tried, so they testified, to deliberately avoid infringement thereof and even obtained a copy of the patent supposedly for this purpose

(R. pp. 134, 139, 140, 165, 166, 170-171, 172).^{*} And on this they had the advice of Mr. Halle, their and appellee's patent counsel (R. p. 140). Thus, these three people apparently understood the disclosure now attacked as so unclear; of course, appellant denies that Kraver and Fritzhand really tried to avoid infringement and contends that infringement was not in fact avoided, but it does seem strange for appellee to claim that it clearly avoided infringing a patent the disclosure of which it contends is too indefinite.

The only reason for defining in the patent the modifying copolymer as a Buna S with a high styrene content was to distinguish it from butadiene-styrene copolymers having the standard amounts of styrene or lower amounts of styrene and which would not modify polystyrene as required by the inventor. The modifying copolymer employed by appellee does have a substantially higher styrene content than the standard and does accomplish modifying the polystyrene in the manner disclosed by the suit patent. Thus, the patent obviously was sufficient to teach the infringer herein what to do and no amount of semantic argument to the contrary changes this.

Regarding the court's holding (R. p. 40), that the patent does not set forth the best mode contemplated by the inventor for carrying out his invention, it is desired to point out that there was no evidence whatsoever to support this. The patent does set forth the best mode *contemplated* by Coleman. Certainly there is nothing in the record to the contrary. Apparently what the Court really meant is that

^{*} Fritzhand testified:

“Q. Did you read the patent? A. Yes.

Q. You understand patents? A. To a certain extent. A layman's understanding.

Q. Do you understand sufficiently to know what plastic is referred to in it? A. Yes' ” (R. p. 172).

Coleman's mode did not turn out to be *the* best one. But the patent law only requires that the inventor set forth the best mode which *he* knows of at the time, and there is no evidence showing that this was not done in the case of the suit patent. The fact that subsequent events or developments may have shown that there is a better way of carrying out the invention does not result in non-compliance with the law; and the only question in such a situation is whether the subsequently employed so-called better mode used by an alleged infringer comes within the claims. The validity of a patent is not affected by the fact that the inventor did not at the application date know what actually turned out to be the best mode of carrying out the invention (see cases cited at pp. 55-56, *infra*). Any other holding would require an inventor to withhold disclosure till he was sure he had the best mode of carrying out his invention, and this is contrary to the policy of the patent law, would put a premium on delay in filing, and would result in an improper extension of the patent monopoly.

POINT VII

The court erred in holding the appellant bound by the inventor's statements as to the meaning of the term "Buna S having a high styrene content" and in holding the disclosure indefinite and the patent not infringed because of these statements.

A major error made by the trial court was in holding that "there cannot be enough disclosure [with respect to the meaning of the phrase Buna S having a high styrene content] if the inventor can disagree with the theory on which his assignees try the lawsuit" (R. p. 433). See also the court's remarks at the bottom of page 426 of the record. This error is of pertinence both on the question of whether the disclosure is adequate and on the question of infringement.

The court's position in this regard is supported neither by logic nor legal precedent. Appellant is not bound by the inventor's own statement of what "Buna S with a high styrene content" means to him. Even more important, however, the inventor in the present case did not even purport to give more than an uneducated *guess* as to what "high styrene content" meant. As already mentioned, Coleman is not a chemist and his invention was to make battery hold-down frames from a particular type of plastic which would give the requisite characteristics. The plastic he suggested was polystyrene that had to be modified with a particular substance. It turned out that this particular substance was known as a Buna S with a high styrene content. But what the scientific or chemical meaning of the term itself was Coleman did not know. And it was not necessary that he know since the term speaks for itself and communicates to one skilled in the art all that is necessary to practice the invention.

The law is clear that an assignee of a patent is not bound by statements of the inventor. Any other rule would put the assignee at the mercy of an inventor who through ignorance or even malice might make statements adverse to the assignee's case. See cases cited *infra*, pp. 61-62.

The importance attached by the court to Coleman's guess is attested by the quoting of his testimony in this regard in the opinion (R. pp. 22, 29-30). Even what the court quoted shows that Coleman was just guessing. In addition, however, the following testimony by Coleman unfortunately was not included by the court in its opinion:

"Q. You testified before that you thought that buna S with a high styrene content would have over 50% of the styrene, is that correct? A. That's right.

Q. Is that something based on knowledge or is that a guess? A. That's purely a guess. I have no way of knowing. I took from the high styrene that's what they meant'" (R. p. 386).

It is respectfully submitted that valuable patent rights cannot be destroyed because an uninformed inventor, admittedly not a chemist or expert, disagrees with his assignee's expert witness. Yet this is exactly the result of the decision of the lower court in this case.

POINT VIII

The law applicable to the question of validity.

1. *Presumption of Validity and Burden of Proof.*

The presumption of validity of a patent was deemed of such importance that it was included in the codification of the Patent Law of 1952 in Section 282 of 35 U. S. C. As a result, the burden is heavily on the party contending for invalidity to show this by clear and convincing proof (35 U. S. C. 282); *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F. 2d 91 (C. C. A. 9, 1945).

This court in *Park-In Theatres, Inc. v. Rogers, et al.*, 130 F. 2d 745 (C. C. A. 9, 1942) clearly sets forth the law on this point:

“The issuance of the patent is presumptive evidence of invention and patentability. The presumption is so strong that in the event of a reasonable doubt as to patentability or invention that doubt must be resolved in favor of the validity of the patent” (p. 747).

See also *Massa v. Jiffy Products Co., Inc.*, 240 F. 2d 702 (C. A. 9, 1957)—to the effect that the presumption of validity of a patent arises from the expertness of the administrative agency issuing the patent; *Patterson-Ballagh Corp. v. Moss*, 201 F. 2d 403 (C. A. 9, 1953); and *Hazeltine Research, Inc. v. Avco Manufacturing Corporation*, 227 F. 2d 137 (C. A. 7, 1955).

Commercial success was established in the instant case and this has been held to strengthen the presumption of validity. *Research Products Co. Ltd. v. Tretolite Co.*, 106

F. 2d 530 (C. C. A. 9, 1939). Moreover, the fact that an application for patent received lengthy consideration in the Patent Office including even review by an appellate tribunal in the Patent Office also strengthens said presumption. As was said in *S. H. Kress & Co. v. Elie P. Aghnides, et al.*, 246 F. 2d 718 (C. A. 4, 1957):

“...and the usual presumption of validity is strengthened by the history of this patent in the Patent Office. It was granted only after considerable controversy and after review by the Board of Appeals, where the references relied on by the defendant were all closely considered by administrative officials possessing special competence in the field” (p. 721).

It is to be noted that in the present case the patent was issued only after an appeal to the Board of Appeals which considered some of the references on which the trial court placed its strongest reliance. See also *Trane Co. v. Nash Engineering Co.*, 25 F. 2d 267 (C. C. A. 1, 1928).

2. *Long-Felt Need.*

The doctrine in patent law that satisfaction of a long-felt need in an industry or trade is highly probative of invention is an old and accepted one. Rather than burden this discussion with the numerous citations and quotations possible, it will suffice to refer to the statement of the Supreme Court in the case of *Goodyear Tire and Rubber Company, Inc. v. Ray-O-Vac Company*, 321 U. S. 275, 64 S. Ct. 593, 88 L. ed. 721 (1944):

“Viewed after the event, the means Anthony adopted seems simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was

discovered it commended itself to the public as evidenced by marked commercial success" (p. 279 of 321 U. S. ; p. 724 of 88 L. ed.).

The foregoing quotation fits the facts in the present case very aptly. The problem of producing a safe and adequate battery hold-down frame was proved to have been present for almost forty years throughout which period the use of storage batteries increased tremendously with the increase in production of automobiles, and the need for remedying the problem obviously also became greater. As in the *Ray-O-Vac* case, the solution to the problem proposed by the inventor of the suit patent herein seems simple—after the invention was made. It was not so simple before.

In upholding the validity of a very simple patent for a weeping doll, the Court of Appeals for the Fourth Circuit in the case of *Brown v. Brock*, 240 F. 2d 723 (C. A. 4, 1957), made the following significant statement:

"The record here shows a longfelt and unsatisfied want for an acceptable weeping doll. As we have seen, a number of devices were attempted, but none served the purpose. If any solution to the problem had been obvious, it would not have been overlooked in the industry for want of desire or effort. Notwithstanding the persistent search of the doll industry, the solution achieved by Senior did not seem obvious to anyone else until he conceived and embodied it in the patent in suit. The contention of obviousness is more readily conceived *after* the event than is the solution while the problem remains unsolved. In respect to patents, as in other concerns of life, human experience teaches that 'obviousness' is often much clearer after the event than before; solutions which have remained persistently elusive leap distinctly into view after someone else has pointed them out" (p. 727).

Said statement is believed to be a perfect description of the situation in the present case.

3. *Commercial Success.*

Although commercial success alone will not supply the element of invention where it is otherwise lacking, this factor has always been considered of great importance. The Supreme Court so held in the *Ray-O-Vac* case, *supra*, and so has this court on many occasions. See, for example, *Research Products Co. Ltd. v. Tretolite Co.*, *supra*.

Quite recently, the Court of Appeals for the Seventh Circuit in *Unilectric, Inc. v. Holwin Corporation*, 243 F. 2d 393 (C. A. 7, 1957) said:

“Its commercial success as shown by the evidence and the facts that United’s sockets are imitative are excellent proofs of its useful advance in the art and its patentable novelty” (p. 398).

See also *Brown v. Brock*, *supra*.

4. *Substitution of Materials.*

It has always been held that substitution of materials can amount to invention. The standard for this type of invention is no different from that applicable to other types of inventions and is simply whether or not the substitution was obvious as measured by the results produced. The leading case on the subject is *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. ed. 952 (1877). In that case the invention was a product made in a defined manner, and the court mentions that the product could not be separated from the process by which it was created. The present case is analogous to *Smith v. Goodyear Dental Vulcanite Co.*, *supra*, since herein it is also an article that is involved although in the instant case the article is defined in terms of its composition from which, again, it cannot from an inventive point of view be separated. The Supreme Court in replying to the contention that the substitution of materials was not patentable and in clarifying

and distinguishing from another case makes the following very pertinent holding:

“It [referring to the other case] does not decide that no use of one material in lieu of another in the formation of a manufacture can, in any case, amount to invention, or be the subject of a patent. *If such a substitution involves a new mode of construction or develops new uses and properties of the article formed, it may amount to invention.* The substitution may be something more than formal. It may require contrivance, in which case the mode of making it would be patentable; *or the result may be the production of an analogous but substantially different manufacture*” (p. 496 of 93 U.S.; pp. 954-955 of 23 L. ed.). (Emphasis supplied.)

The foregoing holding applies directly to the instant case. Certain new properties in the article, i.e., battery hold-down frame, are present therein because of the substitution of materials made by the inventor, Coleman. Indeed, the desire to obtain these properties was the reason for the invention itself, and the invention filled a long-felt need and has been a great commercial success as a result thereof. Even further, it can be said that the result of the substitution produces a “substantially different manufacture” since the plastic frames are so totally different from the old metal ones in their physical and mechanical properties. It is true that their basic holding down function remains the same, but there is the essential difference that the plastic frames have the ability to accomplish this without risk of short circuit, fire, corrosion, breaking the battery, etc. whereas these problems are ever present with the metal frames. Thus, the difference between the two articles can well be said to be one of kind rather than degree.

In the case of *Akme Flue, Inc. v. Aluminite Flexible Flue Cap Co., Inc.*, 27 F. 2d 736 (C. C. A. 2, 1928), one of the claims in suit read as follows:

"4. The combination with a flue pipe through which greasy and sooty gases and vapors are adapted to be passed, of a non-fouling steel wool cooperating with said flue pipe, so that the vapors and gases contact therewith before being discharged from the flue pipe to lessen staining" (p. 736).

Flues having different filters than steel wool were old as was the use of steel wool for other filtering purposes. Nevertheless, the court held the patent valid in the following language:

"We are satisfied that upon this record the patent in suit is not shown to have been anticipated and should be held valid. The substitution of a known material has frequently been held to constitute invention" (pp. 737-738).

Another well-known case where substitution of materials was held to amount to invention is that of *George Frost Co. v. Cohn*, 119 Fed. 505 (C. C. A. 2, 1902) wherein the substitution in a conventional clasp of a button made of rubber instead of metal was held to amount to invention in view of the marked superiority of the article as so constructed. The following quotation is highly pertinent to the present case:

"It is not necessary to the patentable novelty of a device, which consists in employing a new material for an old one in constructing one of its parts, that the substitution should involve the discovery or utilization of an unknown or unexpected property of the material. This is one of the tests of patentable novelty, but it is not the only one. Whether the feature of novelty is the employment of a new material, or a change of adaptation in other respects, the inquiry always is whether what was done involved the exercise of inventive faculty as distinguished from the ordinary skill of the calling. *When the substitution has accomplished a result which those skilled in the art had long and vainly sought to effect, the evidence that it*

involved something beyond the skill of the calling is so persuasive that it generally resolves the inquiry in favor of patentable novelty" (p. 508). (Emphasis supplied.)

The following cases also illustrate the foregoing principles: *C. & A. Potts & Co. v. Frank F. Creager*, 155 U. S. 597, 15 S. Ct. 194, 39 L. ed. 275 (1895)—substitution of steel bars for glass bars held to amount to invention; *Oliver-Sherwood Co. v. Patterson-Ballagh Corp.*, 95 F. 2d 70 (C. C. A. 9, 1938)—substitution of soft rubber for hard rubber on a bearing held to amount to invention; *United Shoe Machinery Corp. v. E. H. Ferree Co.*, 64 F. 2d 101 (C. C. A. 2, 1933)—substitution of aluminum alloy arm for cast iron arm used in clicking machine for manufacturing shoe uppers held to amount to invention; *Lowe v. McMaster*, 266 Fed. 518 (C. C. A. 3, 1920)—substitution of a solid for a liquid fuel in vulcanization apparatus held to amount to invention; and *Hogan v. Westmoreland Specialty Co.*, 163 Fed. 289 (Circuit Court, E. D., Pa., 1908), *aff'd* 167 Fed. 327 (C. C. A. 3, 1909)—substitution of celluloid for other materials previously used in making the cap for a dredge for salt or pepper held to amount to invention.

The question of whether there is invention in a substitution of materials is related to the question of whether the use by the patentee of a particular type of material is a non-analogous one. Indeed, the same considerations apply since whether a use is analogous or not should be determined by considering whether the use was made previously in the face of a long-standing problem requiring solution. Such is the holding of the case of *Smith v. Good-year Dental Vulcanite Co.*, *supra*.

Also on point is the language of *In re Covey*, 63 F. 2d 982 (C. C. P. A., 1933) where the Court of Customs and Patent Appeals said:

"It would seem, therefore, in view of the years of effort by tire manufacturers and others to solve the problem

confronting appellant, that, if the use of crepe rubber for the tread of tires is analogous to its use for the soles of shoes, and obvious to one skilled in the art, it would have occurred to some one at an earlier date. See *In re Fawick*, 56 F. (2d) 873, 19 C. C. P. A. 1124.

“We are of opinion, therefore, that the use of crepe rubber for the tread or wearing surface of tires is not analogous to its use for soles of shoes; that, in view of the foregoing considerations, such use by appellant was more than a mere substitution of a superior, for an inferior, material, or of one well-known form of a particular material for another well-known form of the same material; and that it required the exercise of the inventive faculties to produce appellant’s tire. See *Potts v. Creager et al.*, 155 U. S. 597, 15 S. Ct. 194, 39 L. Ed. 275; *Lakewood Engineering Co. v. Walker* (C. C. A.) 23 F. (2d) 623” (p. 983).

Coming specifically to the present case, polystyrene concededly is one of earliest plastics made and was available many years prior to the present invention; Buna S’s were known back in World War II (R. pp. 193-194). And butadiene and styrene, the raw materials of a Buna S, were themselves old and well-known substances long prior to the instant invention. Nevertheless, the substitution of materials made by Coleman in order to produce plastic battery hold-down frames to replace the defective metal frames was not made until Coleman’s invention in spite of the long-felt need. It is urged that in view of this and the results of the present invention, the present case comes within the rule of the above-cited cases. The Board of Appeals in the Patent Office concurred in this as is shown by its decision and in particular the portion quoted at p. 32 hereof, *supra*. *Freedman v. Overseas Scientific Corporation*, 248 F. 2d 274 (C. A. 2, 1957) is also pertinent on this point—see particularly the second complete paragraph on page 276.

5. *Utility.*

It has already been argued that appellee failed to establish that appellant's frames made with its original formulation lacked utility (*supra*, pp. 28-30). In addition, however, to finding contrary to the weight of the evidence that appellant's said frames lacked utility, the trial court in its holding on this point is in direct conflict with certain basic legal principles applicable to the question of utility. More specifically, even if it were true as the court found in finding of fact 47 (R. p. 52) that appellant's frames at first were not "unqualifiedly commercially acceptable," under the law this would not constitute lack of utility sufficient to invalidate the patent.

Utility is established even if only partial success is obtained. Thus, in *Freedman v. Overseas Scientific Corporation, supra*, it was held that:

"An article invented may have patentable utility even though the patented device is not unfailingly operable in all its applications. *Hildreth v. Mastoras*, 257 U. S. 27, 42 S. Ct. 20, 66 L. ed. 112" (p. 276).

The matter was stated thus by the Court of Appeals for the Seventh Circuit in the case of *National Slug Rejectors, Inc., v. A. B. T. Manufacturing Corporation*, 164 F. 2d 333 (C. C. A. 7, 1947):

"As to utility, it may be said the invention was of small coverage and of even smaller importance. If the coin selector made possible the rejection of underweighted coins, or served better to eject such coins, it possessed utility. It is not the extent of the utility that governs, but the existence of *some* utility" (p. 335).

To the effect that partial success is a sufficient showing of utility and that commercial success is evidence of utility, see the *University of Illinois Foundation v. Block Drug Co.*, 133 F. Supp. 580 (D. C., E. D., Ill., 1955), affirmed 241 F. 2d 6 (C. A. 7, 1957).

See also *Technical Tape Corp. v. Minnesota Mining & Manufacturing Co.*, 143 F. Supp. 429 (D. C., S. D., N. Y., 1956), aff'd 247 F. 2d 343 (C. A. 2, 1957), holding that in the absence of proof of total incapacity the defense of non-operativeness or non-utility is not available.

6. Sufficiency of Disclosure.

As has already been argued, the holding by the lower court that the suit patent lacked a sufficient disclosure is predicated on the misconception that the suit patent is a patent for a chemical combination. Furthermore the lower court applied the wrong legal standards on this point. First of all, as pointed out by the Court of Customs and Patent Appeals in *In re Hudson*, 205 F. 2d 174 (C. C. P. A., 1953):

"The certainty required in patents is not greater than that which is reasonable *having regard to the subject matter involved*. *Minerals Separation, Ltd. v. Hyde*, 242 U. S. 261. This well established proposition of law readily lends itself to flexible and practical application in appraising the sufficiency of patent disclosures. That a claim should be clear and definite is, of course, elementary, but the degree of definiteness necessary to satisfy the law varies in accordance with the facts and circumstances of each case" (p. 177). (Emphasis supplied.)

The foregoing is of particular importance in appraising the present disclosure. Certainly, if patentability resided in certain critical limitations as to amount and composition, the proportions and definitions required by the trial court would be necessary; and in such case the fact that experimentation might be required to practice the invention could be fatal as far as sufficiency of the disclosure is concerned. On the other hand, however, there are many situations where the invention of a valid patent cannot be practiced without preliminary experimentation. Mr. Miller testified to this from the point of view of a man skilled in his par-

ticular field and having knowledge of patents from a practical point of view (R. pp. 427-428). It is respectfully submitted that in view of the nature of the present invention, a degree of precision in the disclosure which would avoid any preliminary experimentation at all was not required, and as a result the fact that some experimentation with proportions and molding methods may be required does not render the disclosure insufficient.

The foregoing is supported by the case of *Minerals Separation, Ltd. v. Hyde*, 242 U. S. 261, 37 S. Ct. 82, 61 L. ed. 286 (1916) wherein the court pointed out that the fact that preliminary tests might be required does not prevent the disclosure from being adequate:

“Equally untenable is the claim that the patent is invalid for the reason that the evidence shows that when different ores are treated preliminary tests must be made to determine the amount of oil and the extent of agitation necessary in order to obtain the best results. Such variation of treatment must be within the scope of the claims, and the certainty which the law requires on patents is not greater than is reasonable having regard to their subject matter” (p. 270 of 242 U. S.; p. 293 of 61 L. ed.).

The case of *Research Products Co., Ltd. v. Tretolite Co.*, *supra*, in this circuit is very pertinent to the present point. In said case this court upheld the sufficiency of the disclosure in the patent in suit in spite of the fact that

“Thus far it is clear that the patent is indefinite leading as it does to experimentation to determine the particular chemical of a class to be used in each instance” (p. 532).

Other pertinent cases are: *Seabury & Johnson v. Charles G. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553 (1894); *Snow v. Kellar-Thomason Co.*, 241 Fed. 119 (C. C. A. 9, 1917); *In re Storrs*, 245 F. 2d 474 (C. C. P. A.,

1957); *In re Chilowsky*, 229 F. 2d 457 (C. C. P. A., 1956)—see headnotes 7 and 8, page 462.

Another factor in the court's decision relating to alleged insufficiency of the disclosure was the holding and finding that the patentee did not point out the best method of practicing his invention. It is a well established principle that a patent need not set forth *the* best mode of carrying out the invention; what is required is that it disclose *what the inventor believes or contemplates or conceives* to be the best mode of carrying out the invention. If this were not the rule, deserving persons giving the public the benefit of their ideas would be deprived of their rights simply because subsequently it turns out that those ideas can be, as is very often the case, improved upon. In the case of *Smith v. Carter Carburetor Corporation*, 130 F. 2d 555 (C. C. A. 3, 1942), the court held:

"It is well settled that an inventor need not choose the most efficient mode of carrying out his invention. If such were the requirement, many patents would be of little value as protection against disclosure. While an inventor is required to describe what he conceives to be the best mode for carrying out his idea, he is not confined to that. [Cases cited omitted.] Ericson did what the patent laws require of an inventor. He explained the principle of his invention and what he considered the best mode of applying that principle [citation omitted]. The fact that he did not choose what subsequently turned out, in practice, to be the best structure for applying his principle did not serve to render his disclosure worthless" (p. 559).

In this case the court also pointed out that if the patented mechanism worked for its intended purpose *even though crudely* the disclosure would be sufficient. See also *Hobbs v. Wisconsin Power and Light Company*, 250 F. 2d 100 (C. A. 7, 1957).

It is respectfully submitted that the instant patentee set forth the best mode of carrying out his invention conceived by him and that products made in accordance with that disclosure worked far better than crudely.

Coming now to the question of how the invention of the suit patent is claimed, it is believed that under the circumstances it was perfectly proper to claim the article in terms of its composition and physical characteristics. The following cases hold that this is permissible where the only way in which an invention of an article of manufacture can be adequately described is with reference to what it is made of:

Smith v. Goodyear Dental Vulcanite Co., supra; Akme Flue, Inc. v. Aluminite Flexible Flue Cap Co., Inc., supra; General Electric Co. v. Independent Lamp & Wire Co., Inc., 267 Fed. 824 (D. C., N. J., 1920); *Ex parte Charch*, 102 USPQ 363 (Patent Office Board of Appeals, 1953); *Ex parte Robinson*, 102 USPQ 219 (Patent Office Board of Appeals, 1952); *Ex parte Lessig and Headley*, 57 USPQ 129 (Patent Office Board of Appeals, 1943).

7. The Admissibility of the Ditz et al. Patent.

The patent to Ditz *et al.* was offered and accepted in evidence as prior art despite the fact that it issued subsequently to the filing date of the suit patent. Appellant objected to admitting the patent for any purpose on the ground that it was not prior art because of its issue date and on the ground that it did not show that the inventor of the suit patent was not the first inventor because it (the Ditz *et al.* patent) does not relate to the same invention as that of the suit patent. The court overruled these contentions on the authority of the case of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U. S. 390, 46 S. Ct. 324, 70 L. ed. 651 (1926) as codified in Section 102(e) of Title 35 of the U. S. Code. It is respectfully submitted that neither the *Milburn* case nor Section 102(e) are authority for ad-

mitting a subsequently issued patent as prior art and that the improper admission of the Ditz *et al.* patent for this purpose or, indeed, for any purpose was a serious error requiring reversal. Before discussing this matter in greater detail, it is desired to point out that the lower court and appellee regarded the Ditz *et al.* patent as one of the most powerful weapons against the suit patent because it discloses practically the same plastic as that employed by appellee for its frames. That the Ditz *et al.* patent nevertheless does not show lack of invention in the suit patent has already been argued, *supra*, pp. 32-33, 36.

Until the decision in the *Milburn* case aforesaid, there was no question but that a patent operated as prior art from the date of its issuance, not the date it was filed. See, for example, *Hamilton Beach Mfg. Co. v. P. A. Geier Co.*, 230 Fed. 430 (C. C. A. 7, 1916), which case is merely exemplificative of many similar cases. Subsequent to the aforesaid decision, doubt has apparently been cast on this proposition due to the failure of courts to appreciate the specific issue that was before the Supreme Court in the *Milburn* case and what exactly that court decided in said case. For this reason, a brief review of the *Milburn* decision itself is necessary; and since it is conceded that Section 102(e) is no more than a codification of the *Milburn* case, all of the following discussion with respect to that case applies equally to the interpretation of Section 102(e).

In the *Milburn* case a patent relied on for invalidating the suit patent disclosed the subject matter of the suit patent but did not claim it. This patent issued subsequently to the filing date of the suit patent although the application for it had been filed earlier than the application on which the suit patent issued. The Second Circuit Court of Appeals held that the alleged invalidating patent could not be prior art and that on the issue of whether the suit patent represented a first invention the alleged invalidating patent could only be pertinent *if it claimed*, not merely disclosed, the invention of the suit patent. The theory of this was

that one is not an inventor who does not claim his invention. The Supreme Court in reversing this holding held that a patent serves to show that the patentee of a suit patent is not the first inventor regardless of whether or not the invalidating patent claims as well as discloses the subject matter which is urged to show the patentee of the suit patent not to be a first inventor. Stated another way, the Second Circuit Court of Appeals had held that while a prior art patent is effective as to what is disclosed and claimed, a patent not in the prior art but serving to show that an alleged inventor was not the first inventor was effective only as to what was claimed. And the Supreme Court simply held that for the purposes of showing that an inventor was not the first inventor, a patent not in the prior art was effective both as to matter disclosed or claimed.

It is readily seen from the foregoing that the issue in the *Milburn* case was a very narrow one, and the question was not at all whether or not a patent issuing subsequent to the filing date of a suit patent on an application filed prior to the filing date of the suit patent was prior art. And it follows from this that the *Milburn* case and Section 102(e) codifying it in no way have disturbed the law to the effect that a patent speaks as prior art as of its issue date.

For a discussion corroborating the foregoing, the court is respectfully referred to the case of *Old Town Ribbon & Carbon Co., Inc. v. Columbia Ribbon & Carbon Mfg. Co., Inc.*, 159 F. 2d 379 (C. C. A. 2, 1947) in which, on page 381, the Court of Appeals for the Second Circuit through Learned Hand analyzes just what happened in the *Milburn* case. This case and others in the Second Circuit accordingly continue to hold that a patent speaks as prior art as of its issue date. See, for example, *Stelos Co., Inc. v. Hosiery Motor-Mend Corporation*, 72 F. 2d 405 (C. C. A. 2, 1934), *aff'd* 295 U. S. 237, 55 S. Ct. 746, 79 L. ed. 1414 (1935) wherein it is stated:

"Stephens [the patent in suit] filed his application on September 24, 1923, three months after Semonsen, and although Semonsen's patent was still in the office and did not count as prior art, Stephens was not the first inventor [citing the *Milburn* case]" (p. 406).

The reasoning behind the position contended for herein is basic. Prior art refers to that which is in the public domain, and although an inventor is charged with knowledge of the prior art even though he may not in fact have such knowledge, he cannot be charged with knowledge of what by law is secret, and patent applications until they issue are secret. The same law and reasoning which prevent a secret prior use or secret prior knowledge from invalidating a patent and which preclude an inventor from being charged with knowledge of such uses and prior knowledge prevent him from being charged with knowledge of the disclosure and claims of a patent before it issues.

This court held back in 1920 that a patent speaks as an anticipation from its date of issuance, not its date of application. *Perfection Disappearing Bed Co., Inc. v. Murphy Wall Bed Co.*, 266 Fed. 698 (C. C. A. 9, 1920); cert. den. 254 U. S. 652, 41 S. Ct. 149, 65 L. ed. 458 (1920). It is believed that this case is still good law. In fact, as recently as 1957 the case was cited for the proposition that a patent speaks as an anticipation from the date of its issue. This was in *East Rutherford Syringes, Inc. v. Omega Precision Medical Instrument Co., Inc., et al.*, 152 F. Supp. 497 (D. C., N. J., 1957). The court in the *East Rutherford* case also points out, as mentioned above, that the issue in the *Milburn* case was priority of invention, i.e., the defense that the patentee was not the original and first inventor (see pages 501 and 502).

A very apt statement of the proposition advanced herein occurs in *Baltimore Paper Co. v. Oles Envelope Co.*, 13 F. Supp. 951 (D. C. Md., 1936), (affirmed 89 F. 2d 279 (C. C. A. 4, 1937)), wherein the court stated:

“The defense of prior art rests on disclosure. There could be no disclosure to the plaintiff of defendant’s application while pending in the Patent Office. But the defense of prior invention rests on actual first conception of the idea. *In other words, in order for the prior applicant to be the first inventor, his patent application must actually disclose the thing patented to a later applicant.* Such was the holding in *Stelos Co. v. Hosiery Motor-Mend Corporation* (C. C. A.) 72 F. (2d) 405, based upon what we understand to be a proper interpretation of the rule laid down by the Supreme Court in *Milburn Co. v. Davis, etc., Co.*, 270 U. S. 390, 46 S. Ct. 324, 70 L. Ed. 651” (pp. 954-955). (Emphasis supplied.)

Coming to the present case more specifically, it is believed to be abundantly clear that the Ditz *et al.* patent should not have been admitted as prior art but that the court nevertheless so admitted it and relied heavily on it as prior art. The patent, however, was not even admissible on the issue of prior inventorship because it is not for the same invention as that of the suit patent. In view of the fact that the suit patent relates to battery hold-down frames and the Ditz *et al.* patent to the molding of battery containers, it is not seen how the disclosure of the Ditz *et al.* patent could possibly be for the same invention as that of the suit patent; in other words, the Ditz *et al.* patent simply cannot be an anticipation. Perhaps the lower court thought it was an anticipation because the Ditz *et al.* patent shows the type of plastic which the appellee’s accused frames are made of. But, as appellant has tried to make very clear, the invention of the suit patent is not of a composition or chemical combination but of an article.

The strict standard applied in this Circuit in determining whether an anticipation is present or not is shown in the case of *Stauffer v. Slenderella Systems of California, Inc.*, 254 F. 2d 127 (C. A. 9, 1957), wherein this court stated:

“Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a prior pleaded patent, there is no anticipation” (p. 128).

The Ditz *et al.* patent cannot possibly meet this standard, and to be admissible in view of its issue date it must meet this standard. The claim in suit involves far more than a composition and includes limitations as to what the article itself is and certain mechanical elements which it must have. The Ditz *et al.* patent does not have all of the same elements, cannot have them in the same situation, and, of course, the elements mentioned therein are not united to function at all the same as the article disclosed and claimed in the suit patent. The Ditz *et al.* patent relates to battery containers, heels for shoes and the like; regardless of what the latter are made of, they cannot be the same as a battery hold-down frame.

8. A Patent Owner Is Not Bound by the Inventor's Statements.

The basic reasons why a patent owner in litigation should not be bound by statements of the inventor of the suit patent are that the latter may in some cases not fully understand his invention and in other cases may have an interest adverse to that of the patent owner. The point is that although any witness' statements regarding the interpretation of a patent may possibly be of some evidentiary value, such statements are not binding upon the court and do not foreclose a plaintiff merely because the witness is the inventor.

A case in this circuit clearly supporting the above is *Celite Corporation v. Dicalite Co.*, 96 F. 2d 242 (C. C. A. 9, 1938). In said case there was a conflict in testimony of experts as to how the inventor's process operated. In dealing with the matter this Court made the following significant statement:

“However this may be, we deem it immaterial to the validity of the patent, as it is not essential that an inventor understand the exact nature of the physical or chemical changes involved or resulting from his process, if the product and the process are novel and useful. [Citing cases]” (p. 246).

The foregoing applies to the present case. Coleman was asked what a Buna S with a high styrene content was, and the lower court placed great emphasis on his *pure guess* that this meant over fifty per cent in styrene in the copolymer. Obviously Coleman who is a layman and not a chemist (R. p. 367) did not understand the term he was asked to interpret and he admitted this, stating that he was only guessing (R. p. 386). But it was not necessary according to the established law in this circuit and elsewhere that Coleman understand the term *so long as the term was a proper one and had a meaning to persons skilled in the art*. Once this is recognized, the insignificance of any conflict between Mr. Miller’s testimony and Coleman’s becomes readily apparent as does the fact that the patent cannot be held indefinite and not infringed because of Coleman’s guess. See also *In re Storrs, supra*, and *In re Chilowsky, supra*—headnotes 10 and 11.

Another case bearing on this point is that of *Ward v. Shope Brick Co.*, 3 F. 2d 244 (C. C. A. 9, 1925) wherein this court stated:

“... and, if the patent is valid, appellee is not to be deprived of its benefit, however erroneous the explanation and reasoning of its witnesses and council” (p. 246).

See also *Glade v. Walgreen Co.*, 122 F. 2d 306 (C. C. A. 7, 1941) to the effect that a court is not bound by admissions in determining the question of patentability.

9. *Publications Used as Prior Art Must Teach Clearly How to Practice the Invention.*

The court below although finding the disclosure of the suit patent insufficient held said patent invalid over the vaguest, sketchiest and most insufficient disclosures conceivable. Not a single publication or patent cited by appellee had a disclosure teaching the making of a battery hold-down frame of plastic or of the particular type of plastic disclosed by Coleman. It is old and established law that a publication must disclose the invention it is cited against in such clear and exact terms that one skilled in the art could practice the invention from the publication's disclosure. In the leading case of *Seymour v. Osborne*, 78 U. S. 516, 11 Wall. 516, 20 L. ed. 33 (1871) the Supreme Court said:

“Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation” (p. 555 of 78 U. S. and p. 42 of 20 L. ed.).

That the foregoing holding definitely applies also to domestic publications is shown by the case of *Eames v.*

Andrews, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064 (1887) wherein the Supreme Court quotes (p. 66 of 122 U. S.; p. 1073 of 30 L. ed.) the above language from the *Osborne* case while discussing the defense of anticipation by certain printed publications among which were both domestic and foreign publications. See also *Seabury & Johnson v. Charles G. Am Ende*, *supra*. A case in point in this circuit is *Alexander Anderson, Inc. v. Eastman*, 16 F. Supp. 513 (D. C., S. D., Cal., 1936).

Argument—Infringement

POINT I

Background of the infringement.

The proof shows that after appellant had established its plastic battery hold-down frame as a new and highly desirable item in the automotive field, appellee's supplier, Kravex, decided to copy the product. The president of this supplier, Samuel Kraver, testified that not only had he been familiar with appellant's plastic frame for several years but he even gave a sample of appellant's manufacture to his molder, Gary, at the time he was explaining to the molder what to make (R. pp. 139, 165, Pl's Ex. No. 29). Both Mr. Kraver and Mr. Fritzhand of Gary testified that the sample was furnished only in order to avoid infringement, in their far-fetched explanation to prevent the same plastic as that described in the suit patent from being used by them by mistake (R. pp. 139-140, 165-166, 170-172, 180-181). The proof shows, however, that a very short time after Kravex and Gary went into the matter they produced a frame practically identical to appellant's in all respects including even color. Admittedly they did not analyze appellant's frame to see what it was made of nor did they have any one else do this or even attempt at the time to find out what their own plastic was made of, so that the contention that the sample was furnished to avoid infringe-

ment is simply absurd. When confronted with this obvious fact, Mr. Fritzhand testified that the patent is what Kravex and he hoped would help them avoid infringement and the appellant's frame was of assistance for this purpose because he obtained the suit patent number from the same! (R. pp. 170-172.) The truth is that the sample was furnished to aid in the copying—Mr. Fritzhand did not even remember whether he ordered the plastic before or after he saw the suit patent! (R. p. 172.)

POINT II

Proof of infringement.

Infringement of claim 3 was established by the testimony of Mr. Ert, Mr. Miller and the stipulation marked Plaintiff's Ex. No. 63.

Mr. Ert explained how the plastic frames were used and how the parts thereof work with a battery casing (R. pp. 78-79), and the physical exhibits, Pl's Ex. Nos. 42 and 48, constituting samples of the accused frames and appellants show this themselves upon any ordinary physical inspection.

Paragraph 2 of the stipulation, Plaintiff's Exhibit 63, sets forth the material of which the accused frames are made. For the court's convenience this description is set forth below in a footnote.*

Mr. Miller testified on the basis of his knowledge as an expert in the field that this material constitutes a plastic material and that the plastic is polystyrene the mechanical

* "It [appellee's frame] is composed of a physical mixture consisting of a predominant amount of polystyrene, a minor amount of a copolymer of butadiene and styrene, a small fraction of anti-oxidant, and a small amount of pigment. The copolymer consists of butadiene in the range of 58% to 62% by weight and styrene in the range of 38% to 42% by weight" (R. pp. 461-462).

and physical properties of which have been modified by the addition of a Buna S having a high styrene content.*

Miller testified further that from his own physical examination and testing of the accused frames themselves he concluded the plastic of appellee's frames had improved heat resistance, toughness as well as flexibility over that to be expected of unmodified polystyrene. Thus, the material of the accused frames is clearly within the ambit of claim 3 (R. pp. 211-213).

POINT III

The meaning of the term "Buna S having a high styrene content" as far as infringement is concerned.

As far as infringement was concerned, appellee did not contest the fact that its plastic is polystyrene modified by a Buna S whereby the various physical and mechanical properties mentioned in the suit patent are obtained. The contention was made, however, that the modifying co-polymer of butadiene and styrene is not a Buna S with a high styrene content because the percentage of styrene therein is between 38 and 42%.

* "Q. I refer you to paragraph 2 [of Plaintiff's Exhibit No. 63], which you will understand is the composition of the Kravex frame. Is a frame made of that material a plastic frame? A. It is.

Q. And what is the plastic it is made of? A. It is a modified polystyrene plastic, which the modifying agent is a Buna S with a high styrene content.

Q. What is the basis for saying that the polystyrene is modified? A. The statement in the stipulation reads:

'It is composed of a physical mixture consisting of a predominant amount of polystyrene, a minor amount of co-polymer of butadiene and styrene.'

Q. What is the basis for saying the co-polymer is a Buna S with a high styrene content? A. Reading from the stipulation in the same paragraph, it continues:

'The co-polymer consists of butadiene in the range of 58 per cent to 62 per cent by weight and styrene in the range of 38 per cent to 42 per cent by weight' (R. p. 211).

The question of what "Buna S having a high styrene content" means has already been discussed (*supra*, pp. 39-41). Suffice it to say that under the interpretation of the phrase made by appellant's expert the modifying copolymer employed in the composition of appellee's plastic battery hold-down frames to modify polystyrene clearly has a high styrene content.

POINT IV

Appellant is entitled to benefit of the doctrine of equivalents.

Although it is submitted that appellant established clearly that "Buna S having a high styrene content" means a copolymer of butadiene and styrene wherein the styrene content is over 25% so that claim 3 in suit is literally infringed, it is not necessary that this contention be sustained for infringement to be found. The reason is that appellant is entitled to the benefit of equivalents as far as appellee's modifying copolymer is concerned.

Prior to discussing this point in more detail, it is desired to point out that when various Buna S's having different relative percentages of the components thereof are referred to, what is meant is specific substances that either are being or have been synthesized. In other words, the phrase in question refers to known materials and not to purely theoretical combinations of butadiene and styrene totalling 100%. Also, it should be borne in mind that the limitation as to high styrene content in the suit claims and specification is included therein to differentiate the modifying copolymer from standard G.R.S. which would not properly modify polystyrene to give it the qualities required by the inventor. And still further, it is to be emphasized that appellee's copolymer does have a substantially higher styrene content than the standard.

The patentee gave as an example of the type of copolymer he could use one having a styrene content of 70%. But

this was merely an example, and it does not limit Buna S's having a high styrene to those with a styrene content of at least 70% (as in the example) or at least 50% as contended by appellee. Moreover, it also in no way militates against giving the patentee the benefit of an equivalent where a modifying copolymer accomplishing the desired purposes and having a styrene content substantially higher than 25% but not as high as 50 or 70% is employed even if high styrene content be defined as over 50% as contended by appellee.

It is quite clear that the term Buna S having a high styrene content is intended in the claims and specification of the suit patent to refer to a copolymer that will accomplish certain purposes in modifying polystyrene and serves to distinguish such copolymers from those that will not. And the testimony is also clear that the 38 to 42% styrene copolymer employed by appellee as the modifying copolymer accomplishes exactly the same improvement of the mechanical and physical characteristics of polystyrene required by the claim in suit. This was admitted by appellee's expert Stringfield (R. pp. 313-315), and the pertinent testimony by him is set forth in the footnote below.*

* "Q. Let's go back to my question.

You have presented literature going back I believe to '48, at least, showing what you consider a high styrene copolymer being used to modify polystyrene; isn't that true? A. Yes.

Q. And the Bakelite material, which apparently was available in 1952, shows a copolymer of 38 to 42 being used for the same purpose, isn't that true, to improve the qualities of the polystyrene? A. Yes, the Bakelite literature shows, that they used about a 40-42 per cent copolymer as a compounding ingredient in polystyrene in—whatever that early date was.

Q. '52, I believe, is the earliest we have. That is in the stipulation? A. Yes.

Q. That is the same use of the copolymer as the use of the Darex copolymer that is shown in the other literature, isn't that true? A. Yes, that is used in polystyrene for the same purpose.

There is nothing to show whether the percentage used is the same or not, and there are no comparative figures given as to impact resistance. But that copolymer of about 42 per cent styrene is used for the same

Mr. Miller also gave evidence supporting this (R. pp. 211-213), and the Bakelite brochure (Pl's Ex. No. 76) further supports the foregoing.

Another point which is pertinent on the issue of equivalents is that appellee's expert admitted that the line he drew at 50% regarding high styrene content was not a definite one (R. pp. 307-409). Having arrived at an arbitrary standard, he could not say how far below or above 50% one would have to go to get a high or low styrene content Buna S. But that there was some leeway he had to concede. Assuming, therefore, for example, that a butadiene-styrene copolymer having a styrene content of about 50% comes within Stringfield's definition of a Buna S with a high styrene content, the question arises as to whether appellant is to be denied relief because appellant's modifying copolymer is eight percentage points less in styrene content than the arbitrary yet not definite figure of 50%, *bearing in mind that this eight percentage difference, as already pointed out, does not affect the ability of the modifying copolymer to do exactly what the patent specifies and claims as to modifying polystyrene.*

It must further be borne in mind that the suit patent does not purport to be for a highly technical and complex subject in the field of chemistry in which every percentage point is critical but relates to a practical everyday article,

purpose as the earlier copolymers of 70 to 85 per cent polystyrene were used, but is a later development.

Q. These two copolymers, one in the 70's, and one in the high 30's and low 40's, are used for the same purpose— A. To make high impact polystyrene.

Q. And they both are substantially higher than standard GR-S, the 25 per cent copolymer, that is not shown used for that purpose, isn't that true? A. That is right" (R. pp. 313-314).

"Q. Whether you call them [the butadiene-styrene modifying copolymers] resins or rubbers, they are both used for the same purposes as far as modifying polystyrene?

* * * * *

The Witness: Yes, in the plastics industry they are both used for the same purpose" (R. p. 315).

so that small differences of percentages are not of the essence in this case. It is believed the equivalence of appellee's plastic is readily apparent even from the testimony of appellee's own expert.

There is no file wrapper estoppel whatsoever against giving appellant the equivalent contended for. Concededly, the patentee gave up the right to claim frames made of *any* plastic, but this is far from being estopped from obtaining an equivalent as to the particular type of plastic actually claimed, i.e., polystyrene modified by a butadiene-styrene copolymer having a high styrene content.

POINT V

The law applicable to the issue of infringement.

As this Court is well aware, infringement may be literal or by equivalents. Here literal infringement was made out by the testimony of appellant's expert. However, even the testimony of appellee's expert established infringement because of the equivalence of appellee's frame to the patented frame covered by the claim in issue.

The doctrine of equivalents was fairly recently restated in *Graver Tank and Manufacturing Company, Inc. v. Linde Air Products Company*, 336 U. S. 605, 70 S. Ct. 854, 94 L. ed. 1097 (1950). There the Supreme Court clearly stated that the doctrine of equivalents applies to an accused device which performs substantially the same function in substantially the same way to obtain the same result as the claimed device. The Supreme Court further stated that this doctrine operates not only in favor of pioneer or primary inventions but also applies to patents for secondary inventions.

In the instant case the trial court found non-infringement because appellee's modifying copolymer (used to modify the predominant and basic material, polystyrene) was not in its opinion a Buna S having a high styrene con-

tent since there was less than 50% styrene in said copolymer. What the court failed to realize, however, is that appellee's frame in fact nevertheless performs *exactly* (not merely *substantially*) the same function in exactly the same way to obtain exactly the same result as the claimed device. And the court further lost sight of the fact established in the record that appellee's modifying copolymer itself performs exactly the same function in exactly the same manner to obtain exactly the same result as the modifying copolymer for the polystyrene in the suit patent. Appellee's modifying copolymer gives to the polystyrene the same requisite mechanical and physical characteristics without which appellee's plastic frame could not function and could never have seen the light of day on the public market.

Appellee's expert admitted that the modifying copolymer employed in appellee's plastic and believed by him not to have a high styrene content nevertheless does exactly what the modifying copolymer in the patent does and produces the same result (R. pp. 313-315). Thus, appellee's frames are the equivalent of the patented frames, and appellee's modifying copolymer is the equivalent of that disclosed in the patent as far as this case is concerned.

The lower court did not and could not find any file wrapper estopped preventing the granting of an equivalent. The Patent Office cited no art requiring the insertion of the limitation involved on this point or the interpretation thereof contended for by appellee. The limitation is present solely to define what Coleman found would effect the modification he wanted as opposed to what would not. And appellee's specific modifying copolymer was not at all what Coleman was distinguishing from since it did not even exist at the time the limitation was put into the case. In addition, said copolymer has a styrene content much higher than that of standard G. R. S. which is all that Coleman desired to distinguish from in pointing out the invention.

Finally, the claim need not for validity over the art be restricted to the meaning of Buna S having a high styrene content contended for by appellee, so that the granting of the equivalent requested would not render the patent invalid. The patentability of the claim in suit over the art has already been argued at length, *supra*, pp. 31-37, and does not depend in any way whatsoever on a restriction of the phrase being discussed to exactly what appellee claims it means, even if appellee is right as to what the literal meaning of the phrase is.

The following statement in the *Graver* case is of great pertinence herein and applies directly to the instant case:

“What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform” (p. 609 of 336 U. S. and pp. 1102-1103 of 94 L. ed.).

The foregoing principles have been applied in this circuit many times. See, for example, *The Filtex Corporation v. Amen Atiyeh*, 216 F. 2d 443 (C. A. 9, 1954) and *Patterson-Ballagh Corporation v. Moss*, *supra*.

To the effect that an equivalent need not be known at the time of invention, see *Finkelstein v. S. H. Kress Co.*, 113 F. 2d 431 (C. C. A. 2, 1940).

Also, in the case of *Webster v. Speed Corp.*, 158 F. Supp. 472 (D. C., Oregon, 1957), it was held that the doc-

trine of equivalents applies even to narrow patents, and this case was affirmed except for the matter of attorney's fees at 262 F. 2d 482 (C. A. 9, 1959).

It is apparent from the foregoing that appellant's frames have always been made either under the literal terms of the patent claims or under the claims by virtue of the doctrine of equivalents.

CONCLUSION ON PATENT COUNT

Appellee's supplier deliberately copied appellant's patented plastic battery hold-down frame, employing both the suit patent and an actual sample of appellant's manufacture for this purpose. Having successfully appropriated appellant's invention, appellee and its supplier at the trial leveled every conceivable attack possible against what was obviously desirable enough for them to copy lock, stock and barrel. The cases on patent law are filled with appropriate holdings and conclusions as to the posture of such infringers. A very recent and compelling statement aptly fitting this case occurs in *The Guiberson Corporation v. Equipment Engineers, Inc.*, 252 F. 2d 431 (C. A. 5, 1958) wherein, in reversing a holding of non-infringement and directing an entry of judgment finding the patent valid and infringed, the court stated:

“Finally appellant comes boldly out to take its stand and argue that, though this is a combination patent, the facts surrounding the discovery and use of the invention, including the fact that it filled a great want and need for such a well swab, establish beyond dispute that it constituted a distinctive advance in the art and that it is entitled, therefore, if not to the protection accorded a pioneer patent, certainly to reasonable protection commensurate with the scope of its invention. *Hunt Tool Co. v. Lawrence*, 5 Cir., 242 F. 2d 347 and *Southern Saw Service v. Pittsburgh-Erie Saw Corp.*, 5 Cir., 239 F. 2d 339.

We agree with appellant that this is so. We think this is just another of those cases in which when an answer to a long needed want is found, those who wish to take advantage of it and deprive the inventor of the fruits of his invention unite to vie with each other in pointing out how simple it all was and how little worthwhile" (p. 343).

THE UNFAIR COMPETITION COUNT

Argument

Appellant established that appellee's frames were deliberately copied from appellant's frames as to non-functional shape and color.

Appellee was advised by appellant prior to the bringing of this suit that the Kravex frames were an infringement of the suit patent as well as being an unfairly competing item. Despite this, appellee continued to sell the accused frames so that it is quite clear that appellee is not an innocent reseller of someone else's goods but on the contrary is a deliberate accomplice in the acts of patent infringement and unfair competition committed by its supplier Kravex. Since appellee is furthering the illegal acts of its supplier which defended this action and gave appellee a bold harmless indemnity against possible harm, the supplier's (Kravex's) conduct and that of its molder (Gary) are relevant in the consideration of the issues of this case.

As the court will observe upon examination of appellant's and appellee's battery hold-down frames, examples of which are Plaintiff's Exhibits Nos. 48 and 42, respectively, the frames of the parties are identical in appearance. Moreover, the testimony of Mr. Ert, an independent unbiased witness was to the effect that at a distance of several feet he could not tell them apart (R. pp. 92-93). Indeed, the court could not tell them apart (R. pp. 93-94).

There are two grounds on which plaintiff should prevail on the unfair competition count. One is that appellee has participated in Kravex's deliberate imitation of appellant's product in order to deceive the public and trade, and under these circumstances relief will be granted regardless of any question of secondary meaning under the doctrine prohibiting palming off of goods. *Haeger Potteries, Inc. v. Gilner Potteries*, 123 F. Supp. 261 (D. C., S. D., Cal., 1954). The other ground is that appellant established secondary meaning in its frames as to color and shape, and appellee regardless of intent has traded on appellant's good will and wrongfully appropriated the same. *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F. 2d 464 (C. A. 2, 1955).

As to the question of functionality, there is not a shred of evidence in the record tending to show that the color of appellant's and appellee's frames is functional. Not only did the appellee's supplier and molder admit that the plastic of which the frames are made comes in all colors, but it is perfectly obvious that the ability of a battery hold-down frame to perform its functions is totally unrelated to its color. Appellant established that it picked red color, which it has always used, to distinguish its frames from the old metal frames which were black or gray (R. pp. 74-75, 139). Appellee's supplier was fully aware of the color of the old metal frames and of appellant's new frames and adopted the identical color as appellant's despite the availability of other colors (R. p. 170, pp. 138-139). The manifestly spurious reason given for this was that red is a good color in the automotive industry. And the woefully weak proof of this, which, however, was accepted by the trial court, consisted merely of a few red items in the automotive trade, i.e., basically one exhibit, Defendant's Ex. E.

As to shape, the appellee itself introduced an exhibit clearly establishing that the shape of the frames is not functional. What is referred to is Defendant's Exhibit D

which is a steel frame covered with plastic which frame is adapted to do mechanically all that appellant's and appellee's frames will do mechanically but which does not look at all like appellee's or appellant's frames. The court is urged to compare Defendant's Exhibit D with Plaintiff's Exhibit No. 48 (one of appellant's frames) for an unanswerable demonstration that appellee's frames could have been molded by appellee's supplier without copying slavishly the shape of appellant's frames and that said shape is not at all functional. (See also Ert's testimony, R. p. 96.)

It is respectfully submitted that no reason for copying the color and shape of appellant's frames can have existed except to deceive the public and the automotive trade into buying appellee's frames in the belief that they were appellant's. The trial court's Findings of Fact Nos. 9 and 11 (R. p. 42) to the effect that there was no evidence of imitation or deception tending to mislead the public or evidence of actual confusion are simply unsupported by the record and are contradicted by the facts established. Apparently, the court based its holding on the theory that since the products are not sold directly to the public no deception could be present. It is respectfully submitted that deception need not be that of the ultimate consumer for unfair competition to be established. In the present case, it is the retailer of the frames, i.e. the gas station owner, and the like, who is deceived when he goes to an automotive supplies store such as the appellee and sees red plastic frames of exactly the same shape and design as appellant's.

As to secondary meaning, the testimony of the witness Ert showed that appellant's frames are frequently displayed out of their containers in places where they may readily be seen and that said witness and customers identify red plastic battery hold-down frames as appellant's and that such frames are asked for as the "red frames" (R. pp. 75-78, 103-104, 121-122). Moreover, the testimony shows clearly that the market in plastic frames was created by

appellant whose red frames were well known in the trade before appellee and its suppliers embarked on their course of illegal conduct (R. pp. 119, 133).

In addition, the evidence established the following facts:

1. Many of appellant's advertising circulars and all of its boxes for its frames pictured said frames in red.
2. Appellant had sold over 3,000,000 frames of that color and shape prior to the appearance of the Kravex frames (R. p. 256).
3. Appellant had used its color and shape exclusively for upwards of six years before appellee came on the market.*
4. The only plastic battery hold-down frames ever on the market before appellee's were appellant's with their characteristic red color and shape.

Certainly, this evidence in the aggregate sufficed to create a strong presumption of secondary meaning, and the appellee put in no evidence whatsoever to refute such presumption. Indeed, there was actual proof from the trade that pruchasers had come to recognize the red frames as appellant's, and no proof to the contrary. A presumption of secondary meaning by reason of the length of use has been held to exist even without proof from the trade. See *New England Awl & Needle Co. v. Marlborough Awl & Needle Co.*, 168 Mass. 154, 46 N. E. 386, 60 Am. St. Rep. 377 (1897).

Finding of Fact No. 13 (R. p. 43) to the effect that there is nothing in the record to establish secondary meaning is

* Kravex had been making plastic frames for four months at the time its deposition through its president Samuel J. Kravex was commenced on August 7, 1957 (R. pp. 127, 130; Plaintiff's Exhibit No. 61 for Identification). So the Kravex frames first appeared in April, 1957. Appellant went into production in June, 1951 (R. pp. 252-254; Plaintiff's Exhibit No. 30). Thus the appellant's frames had been on the market for about six years before the Kravex frames came out.

contrary to the evidence; the court erred in not finding secondary meaning as to color and shape of appellant's battery hold-down frames.

The court also stated that the appellee could not appropriate the color red in the absence of any imitative deceptive device tending to deceive or to mislead the trade or public (Opinion, R. p. 17)—meaning that the presence of such a device was not proved. But it was proved that there *was* an imitative deceptive device associated with the product, namely, the particular shape.

The court did not recognize the foregoing as shown by several statements in its opinion. Thus, the court states (R. p. 17) that the size of the frames of the parties necessarily has to be similar; appellant, however, did not contend that the *size* of its frames had been imitated, it was the *shape* and *color* which appellant contended and proved had been slavishly copied. And the court held (R. p. 18) that the frames of the parties are not displayed in such a manner when offered for sale that anyone could see them out of their cartons and that the cartons are necessarily similar in size. This is directly contradicted by the unchallenged testimony to the effect that the frames are displayed out of their cartons and where they can be seen by prospective purchasers (R. pp. 76, 78).

It is believed that the well-known case of *Ross-Whitney Corp. v. Smith, Kline & French Laboratories*, 207 F. 2d 190 (C. A. 9, 1953) is clear authority for sustaining the unfair competition count under the facts proved herein. See also *Norwich Pharmacal Co. v. Sterling*, 167 F. Supp. 427 (D. C., N. D., N. Y., 1958); and *The W. E. Bassett Company v. The H. C. Cook Company*, 156 F. Supp. 209 (D. C., Conn., 1957). These cases are directly in point as to color and shape.

CONCLUSION

The judgment appealed from should be reversed and the complaint should be sustained as to both counts and an injunction issued and an accounting for damages and profits awarded appellant. Also, the counterclaim should be ordered dismissed.

Dated: Los Angeles, California
July 17, 1959

Respectfully submitted,

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APPENDIX CONSISTING OF TABLE OF EXHIBITS REFERRED TO IN APPELLANT'S OPENING BRIEF

Plaintiff's Exhibit No.	Page of Record Identified*	Page of Record Offered*	Page of Record Received*
2	4**	20**	20-21**
29	4**	86**	86**
30	4**	317**	317**
42	4**	93	93
48	4**	80	80
54	65	69	69
55	65	69	69
56	67	69	69
57	67	69	69
58	68	69	69
61 for Ident.	127	(Not Offered)	
63	209**	209**	209**
69	195	218	218
70	195	218	218
71	195	218	218
72	195	218	218
76	213	218	218
82	421	556**	559**
83	421	556**	559**
84	421	556**	559**
85	421	556**	559**
86	410	547**	551**
Defendant's Exhibit			
A	11**	295	295
D	43**	83	83
E	88	97**	97**
M	300**	294	294
T	287	288	288

* Unless otherwise indicated, reference is to page of Record on Appeal.

** Page number in upper right hand corner of original stenographic transcript.

